

**United States**  
**COURT OF APPEALS**  
**for the Ninth Circuit**

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MOIST COLD REFRIGERATOR CO., INC., a  
corporation,

*Appellant,*

vs.

LOU JOHNSON CO., INC., a Corporation; MEIER  
& FRANK COMPANY, INC., a Corporation;  
ADMIRAL CORPORATION, a Corporation,  
AMANA REFRIGERATION, INC., a Corpora-  
tion,

*Appellees.*

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**BRIEF FOR DEFENDANTS-APPELLEES**

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**BRIEF FOR DEFENDANTS-APPELLEES**

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**INTRODUCTION**

Appellant has seen fit to charge Judge Solomon with gross abuses, and throughout its brief has characterized him as being precipitous, confused, inaccurate, fallacious and completely ignoring the evidence. At one point, appellant states in its brief, page 57, that Judge Solomon's opinion is "a conglomeration of unsupported statements and fallacies. The opinion below evidences a disregard of logic, law, and the facts of record. We next turn to the equally arbitrary decision on damages." Again, on page 63 of its brief, appellant characterizes Judge Solomon as "basing exclusive reliance on his jaundiced view."

Such *ad hominem* attack is good indication of the weakness of appellant's case and the unjustness of its cause. Even a cursory reading of Judge Solomon's opinion (R. 72-78) and his instructions to the jury (R. 1449-1486) refutes these completely fallacious charges. The Judge's opinion and instructions establish that he was keenly aware of the facts in the case and the applicable law as set forth by this Court and the United States Supreme Court. Obviously Judge Solomon's opinion, which he read in court, was prepared with a great deal of care and in his application of the law to the facts he reached the only reasonable answer. His action in granting defendant a judgment n.o.v., was not precipitous, ill-advised, or any of the names by which appellant calls it. We believe that the ensuing sections of our brief will show that Judge Solomon considered all the evidence and reasonable inferences drawn therefrom in a light most favorable to appellant and, in so doing, came to the correct conclusion that reasonable minds could not differ and that there was no basis for the jury verdict in favor of appellant.

That there is no basis for appellant's vicious attack on Judge Solomon is evidenced by the extremely conscientious manner in which this case was handled by the Judge. Commencing almost one month before the actual trial date, Judge Solomon made himself available at all times to counsel and worked with counsel at numerous pretrial conferences and meetings which extended throughout the period. During the trial he continually requested and received from counsel additional information and numerous memoranda of law dealing with various aspects of the case and particularly the questions of

patentable invention and infringement (see for example R. 382).\*

We believe that Judge Solomon, instead of ignoring the evidence in the case, was fully aware of it and of the method in which it was being presented to the jury. On every occasion he did everything he could to help counsel to present their cases. As the transcript of record shows, throughout the trial he permitted the parties great latitude and was lenient as to admissibility of evidence, questioning of witnesses, etc. The record establishes that Judge Solomon should be affirmed, not condemned, for his excellent display of judicial ability and action.

Appellant's statements of the pleadings, facts and case contain considerable controversial matter and are almost completely barren of references to the printed transcript of record. We shall therefore make a counter statement.

## COUNTER STATEMENT OF THE CASE

### HISTORY OF THE LITIGATION.

Appellant appeals from a final judgment by the District Court for the District of Oregon (Honorable Gus J. Solomon, presiding). The judgment set aside the special interrogatories and general verdict of the jury in favor of plaintiff and against defendant Admiral Corporation in the sum of \$2,093,180, and against defendant Amana

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\*R. indicates page of printed transcript of record.

Pl. Ex.—plaintiff's exhibit.

Def. Ex.—defendants' exhibit.

Aplt's Br.—appellant's brief.

Aplt's Exp.—appellant's expert.

Emphasis added throughout brief unless otherwise noted.

Refrigeration, Inc. in the sum of \$45,575; and granted judgment in favor of defendants (R. 70). In the judgment the Trial Court also ordered, on its own motion, that in the event its judgment for defendants should be reversed on appeal, then the jury's verdict and special interrogatories shall be set aside and a new trial granted on the following grounds: (1) the verdict is contrary to the clear weight of the evidence; (2) the damages awarded plaintiff are excessive (R. 71).<sup>\*</sup> The Trial Court filed an opinion (R. 72) holding the patent sued upon invalid and not infringed, and that there was no rational basis for the damages awarded by the jury.

The patent in suit, which expired October 6, 1953, is Bronaugh & Potter reissue patent No. 23,058, entitled "Refrigerator." (Pl. Ex. 2. Copies of all patents referred to herein are contained in the folder supplied to the Court herewith.)

The original patent was No. 2,056,165, issued October 6, 1936, on an application filed February 16, 1931 (Pl. Ex. 1; see folder of patents). Six claims (the only claims in issue) of the original patent were held invalid by the Court of Appeals for the Seventh Circuit on February 7, 1947, in *Refrigeration Patents Corp. v. Stewart-Warner Corp.*, 159 F. 2d 972, cert. denied 331 U.S. 834, 91 L. Ed. 1847 (1947), on the ground that these claims were vague, indefinite and functional and, therefore, violated R.S. § 4888, 35 USC § 33 (1946).

In another case involving original patent No. 2,056,165, claim 11 (the only claim in issue) was held invalid

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<sup>\*</sup>Although the Trial Court ordered the new trial pursuant to Rule 59(d) FRCP defendants' motion notwithstanding the verdict under item 3 (R. 69) laid the basis for a new trial in stating that the jury verdict was grossly excessive and contrary to the evidence.

on the ground that the subject-matter was first claimed more than two years after public use. *General Electric Co. v. Refrigeration Patents Corp.*, 71 USPQ 236 (W.D. N.Y. 1946).

On June 18, 1948, the patentees filed an application in the Patent Office for reissue of the patent and on December 14, 1948, the reissue patent in suit was granted (Def. Ex. 102).

This suit was filed April 23, 1951 (R. 6) by plaintiff-appellant which was formed in Oregon shortly before filing of this suit (Def. Ex. 120-B first full paragraph p. 2). The patent in suit was assigned to appellant one month before the filing of the suit (Pl. Ex. 17). Appellant has no place of business but only an agent for service in Oregon (Agreed Statement of Fact item 1, R. 31).

The suit was originally filed against Lou Johnson Company, Inc. and Meier & Frank Company, Inc., a distributor and retail dealer respectively of Admiral and Amana refrigerators (R. 3). Subsequently, the manufacturers, Admiral Corporation and Amana Refrigeration, Inc., intervened and assumed the defense (R. 31).

On March 21, 1953, on defendants' motion for summary judgment and on issues segregated under Rule 42(b) of the Federal Rules of Civil Procedure, the District Court entered a final judgment holding all four claims of the Bronaugh & Potter reissue patent invalid on the ground that the reissue was unauthorized since the patentees had made no showing of inadvertence, accident or mistake.

On appeal, this Court on November 24, 1954, reversed and remanded the case for trial (217 F. 2d 39).



The trial resulted in the judgment from which the present appeal is taken.\*

#### SUBJECT-MATTER INVOLVED.

The Bronaugh & Potter reissue patent No. 23,058 in suit (Pl. Ex. 2)<sup>†</sup> relates to a two-compartment, two-temperature refrigerator, with one compartment for frozen foods and ice and the other for foods to be maintained at temperatures above freezing.

Such freezing and cooling compartments in one box were old long before Bronaugh & Potter and it is admitted in the Agreed Statement of Facts of the pretrial order (R. 40) and appellant's brief (p. 15) that all the elements in the patented combination are old.

In 1922, long before Bronaugh & Potter entered the field, the basic elements and organization were disclosed in the Anderson patent No. 1,439,051 (Def. Ex. 105; see folder of patents). Figure 1 of the Anderson patent is reproduced at the back of this brief (Appendix Plate I). Before the patent in suit is discussed, the combination of old, well-known elements, as shown in Anderson, will be outlined.

First, there is a box or cabinet 9. The inside walls and top and bottom of this box and the interior parti-

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\*Appellant's statement (brief p. 1) that the remaining issues to be tried after disposal of the motion for summary judgment were presumably only fact issues is incorrect. Several issues of law were raised by the contentions of the parties in the pretrial order. The usual practice of separately listing issues of law and fact in the pretrial order was abandoned because of the parties' inability to agree thereon.

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<sup>†</sup>Variously referred to hereinafter as "Bronaugh & Potter," "the Potter patent," "Potter," "patent in suit."



tions are provided with insulating material 14. The interior of the box is divided to form three compartments 6, 7 and 8, which are accessible through doors. One compartment 7 is a freezing compartment, another compartment 6 is a food refrigerating or cooling compartment. In the bottom of the box is a space or compartment 8 for the usual machinery, to be described (Aplt's Exp., R. 844-6).

The two compartments 6 and 7 are cooled by the evaporation of a volatile liquid refrigerant in a direct expansion system which passes through a continuous pipe which is made up of coils 34, 40 which extend through each of the compartments 6 and 7. The evaporation of the liquid refrigerant in the coils 34, 40 absorbs heat and thus reduces the temperature of the compartments and their contents (Aplt's Exp., R. 844-7). The larger the heat absorbing surface of the coils is, the more rapid the heat transfer will be (Quinn, R. 684; Bronaugh, R. 152). The evaporation of the liquid refrigerant performs the same function as the melting of the cake of ice in the old icebox and the old icebox had a moist cold condition therein (Bronaugh, R. 97; 406).

The liquid refrigerant is circulated in the coils 34, 40 by means of a pump in the machinery compartment 8 and in absorbing heat from the compartments is changed to a vapor. The continuous pipe which extends through both of the compartments 6 and 7 is connected to a single liquefying unit including a compressor (Fig. 4) in the machinery compartment 8 which changes the vapor back into liquid. The heat which the vapor has absorbed is transmitted to the air outside the box or cabinet. The refrigerant liquid leaves the compressor or

condenser and is returned by the pump to the food compartments. Thus, there is continuous circulation of the refrigerant liquid and vapor (Aplt's Exp., R. 844-9).

The evaporation of the liquid refrigerant is accomplished by lowering the pressure on the liquid. The pressure is lowered in Anderson by passing the liquid through what is called an expansion or reduction valve 33, which is basically a small opening, *adjustable in size*, at or near the entrance to a section of pipe of larger diameter. The pressure in the larger section of the pipe is less than that ahead of the small opening, and evaporation commences as the liquid enters the larger section (Aplt's Exp., R. 847).

A thermostat in the refrigerator cooling compartment 6 controls the "on" and "off" cycle of an electric motor which drives the pump and compressor (Aplt's Exp., R. 850).

The Anderson patent discloses (Aplt's Exp., R. 844-50. See also folder of patents):

1. A cabinet 9.
2. A cooling compartment 6 in the upper section of the cabinet.
3. A freezing compartment 7 in the lower right section of the cabinet.
4. Thermal insulation 14 surrounding each compartment.
5. A section of pipe (coil) 40 located within the cooling compartment 6.
6. Another section of the same pipe (coil) 34 located within the freezing compartment 7.

7. Volatile liquid refrigerant in the pipe (p. 1, col. 2, lines 77-85).
8. An expansion valve 33 in the pipe 34.
9. A single unit (shown generally at 20) for liquefying the vapor formed in the pipe.
10. A thermostat in the cooling compartment for automatically controlling the operation of an electric motor 25 (p. 1, col. 2, lines 91-93).

The refrigerant in Anderson's direct expansion system first runs through coil 34 in freezing compartment 7 and then through coil 40 in cooling compartment 6. The expansion valve 33, which controls the rate of evaporation of the liquid refrigerant and accordingly the temperature, is located in the pipe at the entrance to the freezing compartment 7. The expansion valve is adjustable and depending on its setting one can control the degree of frosting on the coils of the cooling compartment (Aplt's Exp., R. 868, 870).

Long before Bronaugh & Potter entered the field, it was recognized that if the temperature of the coil in a cooling compartment is below freezing, there is a substantial difference in the temperature of the air immediately adjacent the coil and the air at a distance. This causes circulation of air. When the air passes over the below-freezing coil, particularly if the heat transfer surface of the coil is relatively small, some moisture is taken from the air and foods in the compartment and condenses on the coil to form frost. This results to some degree in a dehydration of the food, and also reduces the heat transfer through the walls of the coil (Aplt's Br. 3, 4).

To minimize these effects, it had been common practice to produce a moist cold atmosphere and prevent dehydration in mechanical refrigerators by providing a coil with fins for the absorption and transfer of heat. Thus the coil was more effective in absorbing heat and could be more nearly maintained at an above freezing temperature, to reduce frosting of the coil and dehydration of the foods.

Prior to Bronaugh & Potter, "freezing coils" and "non-frosting"\* coils for refrigerators were well-known and available as stock items (Aplt's Br. 46, 48).

The Larkin patent No. 1,776,235, issued September 16, 1930, on an application filed June 28, 1928 (Def. Ex. 106. Also see folder of patents) shows and describes such a "non-frosting" coil for a *household* refrigerator (Aplt's Exp., R. 861). Larkin fully describes that the fins prevent frosting thereon and dehydration of foods (Aplt's Exp., R. 859, 860; 170).

When Bronaugh & Potter built their first two-compartment, two-temperature refrigerator, they purchased a Larkin finned coil and installed it in the cooling compartment. Prior to that time they were engaged in building refrigerators for commercial use, i.e., stores, butcher shops, etc., in which they used Larkin finned coils.

Bronaugh testified (R. 165):

"\* \* \* We were using Larkin coils in commercial work and the first of the finned coils that I adapted to our experimental work were remodeled out of larger Larkin coils. We later, as I recall, purchased a coil of a size suitable for our purpose."

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\*These two words are quoted because, contrary to what appellant now states, we shall show that appellant's witnesses testified that there is no such thing inherently as a "freezing" or "non-frosting" coil. It all depends on how the coils are *operated*.

Bronaugh further testified (R. 166):

“Q. And were those coils that you purchased on the open market?

A. They were purchased from the Larkin factory which, as I recall, was located down in Georgia.

Q. But they were standard coils?

A. That's right.

Q. And purchased on the open market?

A. That's right.”

#### BRONAUGH & POTTER REISSUE

##### PATENT NO. 23,058 IN SUIT.

The patent in suit, is for a two-compartment, two-temperature refrigerator with one compartment 12, 13 for freezing foods and the other compartment 14 for cooling or refrigerating foods to temperatures above freezing. The first two paragraphs of the patent read as follows:

“This invention relates generally to the art of refrigeration, and particularly to a new form of refrigerator.

“The main object of this invention is the design of a refrigerator which will make it possible at one and the same time and over long or short periods of time to perform several highly desirable tasks, namely to form ice or freeze desserts quickly, to provide cold storage for frozen meat and food stuffs, and to provide storage for food at temperatures above freezing.”

At the back of this brief (Appendix Plate II), Fig. 1 of the Bronaugh & Potter patent is reproduced. The elements of the structure were pointed out by appellant's expert as follows (R. 757-64):

1. A cabinet 10.
2. A cooling compartment 14 in the upper section of the cabinet.
3. A freezing compartment 12 and 13 in the center of the cabinet.
4. Thermal insulation 33, 39, 41, surrounding each compartment.
5. A section of pipe (coil) 25 located within the cooling compartment 14.
6. Another section of the same pipe (coil) 22 located within the freezing compartment 12 and 13.
7. Volatile liquid refrigerant in the pipe (p. 2, col. 1, lines 7-16).
8. An expansion valve 23 in pipe 22.
9. A single unit 15 for liquefying the vapor formed in the pipe.
10. A thermostat 31 in the cooling compartment 14 for automatically controlling the operation of a motor 16.

The terms "coil," "pipe," "pipe coil," "expander," "evaporator," and "boiler" are interchangeably used in the patent in suit, prior art references, and testimony of witnesses. They all mean the same thing and refer to the elements through which volatile refrigerant passes for freezing and cooling purposes (Aplt's Exp., R. 887).

The refrigerator of the patent in suit operates as follows: Volatile liquid refrigerant from a sump or receiver 17 passes through line 24 to coil 22 in the freezing compartment. An expansion valve 23, located in coil 22, is adjusted to control the flow of liquid refrigerant thereby controlling the temperature in the compartment. Vaporization of the liquid refrigerant passing through coil 22 is controlled by the setting of valve 23. The vaporized or partially vaporized refrigerant continues through the cooling coil 25 in the cooling or refrigerating compart-



ment 14. The refrigerant, after absorbing heat from the freezing and cooling compartments and accordingly being in the form of vapor, is then returned through line 26 to a single liquefying unit comprising compressor 15, condenser 18 and receiver 17. The operation of the liquefying unit is controlled by thermostat 31 in the refrigerating or cooling compartment 14.

It is clear from a reading of the original Bronaugh & Potter patent and the original claims submitted to the Patent Office that the inventors believed, and represented to the Patent Office, that their invention was a broad one covering a refrigerator having a compartment for maintaining below-freezing temperatures and another compartment for maintaining temperatures slightly above freezing. Typical of the claims presented to the Patent Office is original Claim 1 which reads as follows:

“A refrigerator having a freezing compartment, and a cooling compartment thermally separated from said freezing compartment.” (Def. Ex. 101, p. 8).

Such claims were consistently rejected by the Patent Office and many years later after many patent solicitors labored on the applications, the inventors ended up with four claims, the broadest of which is Claim 2 which has been parsed to facilitate reading:

- “2. A household refrigerator which in normal operation provides
- above-freezing moist cold air for preserving in a refrigerated condition foods susceptible to moisture loss by evaporation and
  - below-freezing dry cold air and
  - a dry cold surface for preserving foods in a frozen condition,

said refrigerator comprising

- (1) a cabinet having
- (2) a cooling compartment and
- (3) a freezing compartment,
- (4) thermal insulation

around said compartments thermally insulating said compartments from each other and from the outside atmosphere,

- (5) a cooling refrigerant expander having heat-conducting surfaces within said cooling compartment and constructed and arranged to maintain its heat-conducting surfaces at a temperature above  $32^{\circ}\text{F.}$  while withdrawing heat from said compartment,

whereby air in said cooling compartment is cooled thereby to a temperature above  $32^{\circ}\text{F.}$  and is maintained at a humidity whose relative value is at least 100% at  $32^{\circ}\text{F.}$ ,

- (6) a freezing refrigerant expander having heat-conducting surfaces within said freezing compartment and constructed and arranged to maintain its heat-conducting surfaces at a temperature well below  $32^{\circ}\text{F.}$  while withdrawing heat from said compartment

whereby air in said freezing compartment is cooled thereby to a temperature well below  $32^{\circ}\text{F.}$ ,

- (7) volatile refrigerant in said expanders,
- (8) a single liquefying unit

associated with said expanders and constructed and arranged to condense refrigerant expanded by heat extracted from both said compartments,



- (9) the volatile refrigerant circulating through said expanders being the sole heat-extracting medium, and
- (10) a thermostat responsive to the temperature in one of said compartments controlling the operation of said liquefying unit."

Appellant now states (Aplt's Br. 22) that the Bronaugh & Potter invention is for a unitary machine for operating two coils of different proportions so that one is frosting and the other non-frosting. As we understand this statement it means that the inventive advance made by the patent in suit is a *change in proportion* of the cooling coil with respect to the freezing coil. The ensuing argument will show how the Anderson and Davenport patents anticipate this definition of the invention. However, at this point we merely call attention to the fact that appellant has shifted its position in that its expert's appraisal of the alleged invention was different. Mr. Parker very succinctly and directly put his finger on what he considered the invention to be when in comparing the Bronaugh & Potter patent with the Anderson patent, he said that the change Bronaugh & Potter made over Anderson was to provide fins on Anderson's cooling coil. He also admitted that such fin coils for the same purpose were old as shown by the Larkin patent (R. 852-3).

"Q. What I am trying to get at is this: Potter shows one type of coil 25. You say it is a finned coil, 25?

A. Right.

Q. And Anderson shows a coil 40 which does not have fins; that is correct, is it?

A. That is correct.

Q. It is by virtue of the fact that Potter provided fins on his coils that he prevented dehydra-

tion of food in the food compartment; that is correct, isn't it?

A. That is correct.

Q. And so the improvement for the preventing of the dehydration was, in Potter was to provide the coil 25 with fins?

A. That is the change he made.

Q. All right. Then if the cooling coil 40 in Anderson were provided with fins, he would accomplish the same result, would he not?

A. He could have.

Q. Yes, I say he would have if he put fins on it?

A. If he did, yes.

Q. That is right. Now, you have stated that finned coils were old at that time, at the time Potter came into the field?

A. They were.

Q. I know you might have in mind the Larkin patent. You may have something else in mind that you knew of in actual operation because of your extensive knowledge in the refrigeration field.

A. Well, I am familiar with the Larkin patent, but I have also seen other finned coils, of course.

Q. Long before, or at least before?

A. Before, shall we say.

Q. Yes, before Potter?

A. That is right.

Q. For the same purpose of absorbing heat?

A. Finned coils are used to absorb heat; correct."

#### THE REFRIGERATORS CHARGED TO INFRINGE.

Only the Admiral structure will be discussed. For purposes of this case, the Amana structure is generally similar to that of Admiral, and it was stipulated that if Admiral does not infringe, Amana does not infringe; if Admiral infringes, Amana infringes (R. 823).

At the back of this brief are reproduced schematic drawings of the Admiral accused refrigerator. These

drawings are reproduced from Def. Ex. 114-A and Pl. Ex. 8A. Letter references have been added for the sake of clarity (Appendix Plates IV, V).

The Admiral refrigerator has a cabinet with a freezing compartment A and a cooling or refrigerating compartment B, the latter of which as a unit, is removable from the cabinet independently of the freezing compartment. A primary circuit C surrounds the freezing compartment and cools it. A secondary circuit D surrounds the cooling compartment and cools it. These two circuits are separate and distinct and each has its own separate and distinct refrigerant circulating therein. Each circuit has its own separate and distinct unit for liquefying the vapor formed therein (Aplt's Exp., R. 901-2).

In the machinery compartment in the bottom of the Admiral cabinet there is a conventional condenser E and pump F which liquefy and circulate the refrigerant in the primary circuit C only. The pipe C, forming the primary circuit, runs from the condenser E up around the outside of the liner of the freezing compartment A and back to the condenser E.

The pipe D forms the secondary circuit and runs around the outside of the liner of the cooling compartment B. This is known as the "cold wall" type of refrigerator wherein the cooling pipes (without heat absorbing fins) are wrapped around and are in engagement with the outside of the cooling compartment shell (Aplt's Exp., R. 903). The pipe D forms a closed secondary circuit, with no intakes or outlets. The supply of refrigerant sealed in the pipe D circulates therein during operation of the circuit.

The flow of refrigerant in the secondary circuit D is influenced by means of a secondary transfer plate G to which the upper portion of said secondary pipe D is thermally attached. It is when this secondary transfer plate is chilled that it acts as a condenser or liquefying unit to convert the vapor in the secondary circuit back into a liquid. This secondary transfer plate G is secured to a primary transfer plate H to which is thermally connected a portion of the primary circuit freezing pipe C. These transfer plates G and H act as means for transferring heat between the two circuits (Aplt's Exp., R. 898-900).

When liquid refrigerant is passed through the primary pipe C, it chills plates H and G and the adjacent section of secondary pipe D (Aplt's Exp., R. 898-900).

Since heat flows from a warmer to a colder object, the vapor rising into the chilled section of the secondary pipe D is condensed to a liquid by the lowering of the temperature (Aplt's Exp., R. 900). The liquid refrigerant then runs downwardly in the vertical central stem to the bottom of the circuit and flows laterally in opposite directions. The liquid in the secondary circuit absorbs heat from the cooling compartment and accordingly evaporates or boils. The vapor rises in the lateral portions of the secondary circuit D until it reaches the chilled section of the pipe adjacent the transfer plate G, when it is recondensed or liquefies (Aplt's Exp., R. 899-900).

### SPECIFICATION OF ISSUES

On this appeal from a judgment n.o.v., the question before this Court is "whether 'the evidence is such that without weighing the credibility of the witnesses there

can be but one reasonable conclusion as to the verdict' and that such conclusion was the one arrived at by the trial Judge." *Himes v. Chadwick*, 9 Cir., 199 F. 2d 100, 102, (1952).

The Trial Court here reached the one reasonable conclusion as to the verdict because the testimony of appellant's witnesses and the documentary evidence compels the conclusion that the patent in suit is invalid and not infringed, for the reasons set out in the following summary of argument. The jury here "departed from the relevant legal criteria by which either a jury or a judge must be guided in their or his fact-finding function. . . ." *Berkeley Pump Co. v. Jacuzzi Bros.*, 9 Cir., 214 F. 2d 785, 792 (1954).

### SUMMARY OF ARGUMENT

The Trial Court correctly exercised its right and duty in setting aside a jury verdict for plaintiff-appellant which was completely at variance with the standards of invention laid down by the courts.

The Bronaugh & Potter patent is invalid for a number of reasons:

(a) The Anderson patent, which shows a refrigerator like the patented one, has all the elements called for in the Bronaugh & Potter claims and operates in the same way.

(b) The Davenport patent (1,726,344) discloses a refrigerator like the one appellant now defines as the Bronaugh & Potter invention in an attempt to make out infringement.

(c) There is no invention over Anderson in view of the Larkin patent. Larkin teaches the use of a fin coil to produce moist cold which appellant's expert said was the Bronaugh & Potter invention.

(d) The Bronaugh & Potter claims call for no more than an aggregation of old elements which perform the same together as they did separately.

(e) There is no written description of a fin coil in Bronaugh & Potter, and therefore there is no compliance with the statutory requirement for disclosure of the invention.

(f) The alleged invention does not satisfy the criteria and standards of patentable invention established by this Court.

(g) The claims of Bronaugh & Potter are invalid because subject matter claimed therein was first asserted in the patent application more than two years after sale of refrigerators having structure corresponding to the claimed subject matter.

The claims of the Bronaugh & Potter patent are not infringed:

(a) The accused refrigerators are of a different type known as "cold wall" (Davenport 1,726,344) as distinguished from the patent which, according to appellant's own witnesses, is of the fin coil type. These two types of refrigerators are different in structure, function and result.

(b) The claims of the patent call for a single liquefying unit with a single refrigerant. The accused refrigerators have two liquefying units with separate re-



frigerants, and there is no identity of structure, function and result between the patent and accused refrigerators.

(c) The patent is not entitled to any liberal construction because if valid it is for a very narrow improvement.

(d) If the Bronaugh & Potter invention is for a fin coil as urged in the Trial Court, there can be no infringement since the accused refrigerators have no fin coils.

The history of the Bronaugh & Potter patent establishes commercial failure so that even if there were some doubt as to validity of the patent, it is not helped by its past.

The Trial Court's order for a new trial is not reviewable since there was no rational basis for the jury award, and there was no abuse of discretion by the Trial Judge.

Appellant's demands for treble damages, attorneys' fees and costs are completely unfounded. The Trial Judge did not abuse his discretion in these matters.

The judgment of the Trial Court should be affirmed.

## ARGUMENT

### I. THE TRIAL COURT CORRECTLY EXERCISED ITS RIGHT AND DUTY IN SETTING ASIDE THE JURY'S VERDICT AND ENTERING JUDGMENT FOR DEFENDANTS-APPELLEES.

Under the decisions of this Court, the Trial Court had "the right and duty . . . to direct a verdict in a patent case, where the circumstances indicate the jury

has departed from the relevant legal criteria by which either a jury or a judge must be guided in their or his fact-finding function. . . ." *Berkeley Pump Co. v. Jacuzzi Bros.*, 9 Cir., 214 F. 2d 785, 792 (1954); *Kwikset Locks. v. Hillgren*, 9 Cir., 210 F. 2d 483, 486 (1954); *Himes v. Chadwick*, 9 Cir., 199 F. 2d 100 (1952).

In accord: *Packwood v. Briggs & Stratton Corp.*, 3 Cir., 195 F. 2d 971 (1952), relied upon by this Court in the *Himes* case; *Ryan Distributing Corp. v. Caley*, 3 Cir., 147 F. 2d 138, 140 (1945), relied upon by this Court in the *Jacuzzi* case; *Nachtman v. Jones & Laughlin Steel Corp.*, 3 Cir., .... F. 2d ...., 110 USPQ 167 (June 27, 1956).

The language of the Court in the *Packwood* case is apt (195 F. 2d 973-4):

"A jury in a patent case is not free to treat invention as a concept broad enough to include whatever discovery or novelty may impress the jurors favorably. Over the years the courts of the United States, and particularly the Supreme Court, have found meaning implicit in the scheme and purpose of the patent laws which aids in the construction of their general language. In this process, rules and standards have been developed for use as guides to the systematic and orderly definition and application of such a conception as invention in accordance with what the courts understand to be the true meaning of the Constitution and the patent laws. Once such standards and rules are authoritatively announced any finding of 'invention' whether by a court or a jury must be consistent with them.

"This is no peculiarity of patent law. Jury findings of negligence or proximate cause must comport with common law rules devised to give reasonable and systematic meaning to those generalities. \* \* \* And so it is throughout the body of the common



law. This authority and responsibility to keep jury findings within reasoned rules and standards is an essential function of United States judges today as it long has been of common law judges. \* \* \* It stands as a great safeguard against gross mistake or caprice in fact finding.

\* \* \*

"In *Ryan Distributing Corp. v. Caley*, 3 Cir., 1945, 147 F.2d 138, 142, 64 USPQ 257, 260-261, this court pointed out that entry of judgment n.o.v. is the appropriate corrective action when a jury has found a patent valid although the court's application of defining principles reveals 'a clear-cut case of lack of invention'. Also indicating the propriety of thus over-ruling the trier of fact is the already cited *Atlantic and Pacific* case where the Supreme Court reversed a finding of invention duly made and approved by both a district court and a court of appeals. In the instant case the district court should have entered judgment n.o.v. upon the basis of a ruling that, consistent with controlling standards, the device in suit plainly could not embody invention."

In the recently decided *Nachtman* case (*supra*) the Court of Appeals for the Third Circuit discusses the controlling law and expressly reaffirms the principles enunciated in the *Packwood* case. The fact situation in the *Nachtman* case approximates ours since in that case plaintiff obtained from the jury a favorable general verdict, as well as answers to special interrogatories concerning each of the four patents in issue, one of which was a reissue. The Court of Appeals sustained a judgment n.o.v. which set aside a jury verdict for plaintiff at a royalty rate of 2½% on defendant's sales, the verdict amounting to almost one and a half million dollars.

In the case at bar, the Trial Court correctly exercised its right and *duty* in entering judgment n.o.v., as will be shown in the remaining sections of this brief.

## II. THE BRONAUGH & POTTER CLAIMS ARE INVALID.

### (A). The Bronaugh & Potter Claims Are Invalid Because They Are Anticipated by the Anderson Patent.

The disclosure of the Anderson patent (Def. Ex. 105) has been discussed above in the Statement of Facts.

There follows a comparison of the elements of Bronaugh & Potter and Anderson: (See testimony of appellant's expert, R. 844-50, and Appendix Plates I, II.)

<i>Element</i>	<i>Bronaugh &amp; Potter</i>	<i>Anderson</i>
1. A cabinet	10	9
2. cooling compartment	14	6
3. freezing compartment	12, 13	7
4. thermal insulation	33, 34, 41	14
5. section of pipe within the cooling compartment	25	40
6. section of the same pipe within the freezing compartment	22	34
7. volatile liquid refrigerant in the pipe	(p. 2, col. 3, lines 7-16)	(p. 1, col. 2, lines 77-81)
8. expansion valve	23	33
9. a single unit for liquefying the vapor formed in the pipe	15	20
10. thermostat in the cooling compartment	31	(p. 1, col. 2, lines 91-93)

The foregoing comparison of elements we submit speaks more convincingly than any argument either appellant or appellees can make that Anderson is a com-

plete anticipation of the Bronaugh & Potter patent. Undeniably, *Anderson has the same organization of elements as Bronaugh & Potter operating in the same manner to produce the same result.* This, of course, was infringement and explains why Potter bought the Anderson patent (Potter, R. 337).\*

See appendix plate VI for comparison of claim 2 of Bronaugh & Potter with Anderson (also Davenport patent 1,726,344 hereinafter discussed).

It is significant that out of appellant's seventy-one page brief only one paragraph (first paragraph p. 20) directly discusses appellee's admittedly best reference, Anderson. (See later argument with respect to equal pertinency of Davenport 1,726,344.) Appellant tacitly admits that Anderson is the same as Bronaugh & Potter in all respects except that the coils in both of Anderson's compartments are "*necessarily* at a temperature below 32°F." This means that Anderson's freezing coil (34) and cooling coil (40) always frost. The record references cited by appellant do not support appellant's statement (Aplt's Br. 20).

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\*The owners of the Bronaugh & Potter application enjoyed the monopoly afforded by the Anderson patent until its expiration in 1939. Appellant's present assertion of the Bronaugh & Potter patent to cover the same refrigerator as covered by Anderson is an attempt to extend the monopoly of Anderson long after it has expired. For instance, Claim 2 of Anderson reads as follows:

"In a refrigerator, the combination of an enclosing structure, insulated means dividing the structure into a freezing compartment, a refrigerating compartment, and a compartment for operating mechanism, operating mechanism in the latter compartment, a freezing coil connected to the operating mechanism, in the freezing compartment, and a refrigerating coil in the refrigerating compartment connected to the freezing coil and to the operating mechanism."

Anderson is "nonfrosting" in the same sense as Potter. Both frost to a *degree*, depending on the adjustment of the adjustable expansion valve (33 in Anderson; 23 in Potter).

The Potter patent says that some of the refrigerant reaches the cooling coil 25 in *liquid* form, and vaporizes therein (col. 5, lines 10-12). The patent also says (col. 6, lines 3-5):

"There may, of course, occur a slight amount of frosting where the cooling coil 25 enters the compartment 14."

Appellant's expert testified (R. 866-70):

"Q. (By Mr. Byron): Mr. Parker, is there such a thing as a nonfrosting coil and a frosting coil?"

A. You mean in the sense that the coil is inherently frosting or nonfrosting?

Q. Well, in any sense you desire to answer that.

A. No. I think you would have to use those terms in relation to the situation of the coil in a particular assemblage of parts.

Q. I think that's right. You can cause a coil to frost or you can treat the coil so it will not frost, is that correct?

A. That's correct.

Q. And as long as we are on that subject, it's a little bit out of my line here for the moment, but let's take the function of the expansion valve 23 in Potter and the expansion valve 33 in Anderson, or either one. The function of that expansion valve is to control the flow of liquid refrigerant from the high pressure side to the low pressure side, is that correct?

A. That's true.

\* \* \* \* \*

Q. All I have in mind is this: In Anderson if you increase the opening of the expansion valve 33 to the extent that you get liquid refrigerant passing

through the liquid coil, and then passing through a substantial part of the coil 40, you would get an increased frosting? A. I would think so, yes.

Q. Same as you would in Potter, correct?

A. Yes.

\* \* \* \* \*

Q. Well, if the refrigerant were all transformed into a vapor in the refrigerating coil 22, and you had nothing but the vapor passing through the cooling coil 25, would you get any cooling effect in the cooling chamber?

A. I frankly don't know because I don't know what the temperature of the vapor would be.

Q. Under those circumstances would you get any frosting of the coil in the Potter arrangement?

A. No—of the upper coil?

Q. Yes.

A. No, you certainly would not.

Q. And would you get any in the cooling coil 40 of the Anderson patent?

A. If no refrigerant entered the Anderson upper coil to evaporate, I do not see how you could get any frosting on it.

Q. No liquid refrigerant?

A. I mean no liquid refrigerant.

Q. That's right. So they would be the same in that respect?

A. Yes.

Q. You nodded your head. Did you answer?

The Court: Yes, he has answered."

Appellant's expert further testified that in Potter refrigerators which he had seen operate, there was frosting not only on the coil, but on two of the *fins* (R. 1366):

"A. In the two Potter boxes which I had opportunity to see in operation there was slight frosting at the point of entry of the finned—of the tube of the finned coil and there was some frosting on one and I believe two of the fins, which would be at the

left hand of the Potter box, the box in exhibit. There was a slight frost—a little frost, yes.”

As to frosting in Anderson, appellant’s expert testified (R. 825-6):

“Q. Is there a frosting coil in the cooling compartment of the Anderson patent 1,439,051?

A. Yes. In my opinion it would frost some.

The Court: I didn’t hear what you said.

The Witness: It will frost to *some degree* or to some distance in the upper box. The coil or the pipe which, I believe, is numbered 41, goes up into the upper box. In my opinion, it would frost.”

Note that appellant’s expert said that only the vertical pipe 41 of Anderson will frost “some”, not the horizontal coil sections 40 (Fig. 1 Anderson, Appendix Plate I).

Appellant’s witness Bade testified as to the frosting of the cooling coil in the Barry box made by Potter (R. 212-13):

“Q. Well, then, exactly where in this Barry box did you set that frost line?

A. Well, we would come out of the bottom and into the top coil.

Q. Would we pass the top coil?\*

A. Oh, no; you would just use the top coil. There would not be any use to go past the top coil because that is where you get your efficiency out of the job was because when the machine would cycle it would carry just a perfect humidity. In a certain amount of T.D. temperature degrees, the thermostat would kick over, turn it on again, and that coil would be completely defrosted except for maybe if it was real cold we would set that around 32 degrees,

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\*Fig. 1 of the Bronough & Potter patent shows four horizontal coil sections with the refrigerant entering the lowermost and moving upwardly (Appendix Plate II).



which is frosting, and would have just a bead of ice which is something it would take a very good box you buy today that you would have; I don't believe you can buy one. I got one I wish somebody else had.

Q. In other words, the way that you adjust the degree of frost is by setting this valve?

A. The amount of tubing and the amount of length were all figured out later. Like I say, we cut-and-tried a lot of things, a lot of this stuff, and after we tried those things they seen that they had a basis of engineering.

Q. Yes, but you would adjust it with the valve in the expansion coil?

A. In the bottom part of the box.

Q. You might vary the frost line without—almost no limit?

A. Well, if you had horsepower enough, why, you could stretch it all over the room if you wanted to because it would still be an evaporative coil.”

The specification of the Anderson patent also contradicts appellant's incorrect statement concerning this patent. Page 2, lines 35-41 read as follows:

“ . . . . A removable guard of wire netting extends in front of the back member of the coil 40, as at 46, and inside of the side-members of said coil, as at 45, to prevent any food-vessel from being placed where dripping from the coil would fall into such vessel.”

Since Anderson mentions “dripping from the coil”, obviously it was not contemplated that this coil 40 would “necessarily” be at a temperature below 32°F. but that it would normally be above 32°F. because that is the only condition under which dripping could take place. Wire netting is provided in front of coil 40 to prevent food from being dripped upon.

Nor can it be argued by appellant that Anderson is distinguishable on the grounds that he does not have extended surfaces on his coil 40 as Bronaugh & Potter are supposed to have. Figs. 1 and 2 of Anderson show how cooling coil 40 is extended longitudinally and of differing proportions from freezing coil 34 so as to have greater heat conducting surfaces than the freezing coil. The surfaces of the coil are extended vertically by reason of being mounted against the metal inner lining 12 of the cooling compartment and having the wire netting also adjacent the coil. Obviously, the metal liner and wire netting act as extended surfaces for heat absorption for the cooling coil.

Therefore both of Anderson's coils are not "necessarily at a temperature below 32°F." and that to the extent both are, the same applies to Bronaugh & Potter for the identical reasons.

Assuming arguendo that what appellant states about Anderson is correct, the teaching of Bronaugh & Potter could at most amount to instructions to close Anderson's adjustable valve 33 having a handle on it (clearly shown in Figs. 1 and 2 of Anderson's drawings) until cooling coil 40 does not frost. Even if instructions on how to set an adjustable valve could be patentable invention, the fact is that there isn't any such teaching in Bronaugh & Potter. Nothing is said concerning the construction and arrangement of the expansion valve 23 in Bronaugh & Potter and nothing significant could have been said about the valve since it was a well-known device being used precisely the way it was intended.\*

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\*"Adjustability only was involved and adjustability is not invention." (Citing cases.) *Universal Products Co., Inc. v. Montgomery Ward & Co.*, 6 Cir., 146 F. 2d 957, 959 (1945).



Since Anderson is such a complete anticipation of Bronaugh & Potter, it could well be asked how they managed to get by the Patent Office. In the first place, an examination of the file wrapper of the original patent (Def. Ex. 101) shows that the application traveled a rocky road and finally the “antlike persistency” (*Gentzel et al v. Manning*, 230 F. 2d 341, 345) of Bronaugh & Potter’s solicitors succeeded in obtaining a patent where none should have issued.

In attempting to distinguish from Anderson in the Patent Office, Bronaugh & Potter made the following representations to the Examiner (Def. Ex. 101, pp. 82, 83):

“However, nothing is said in the Anderson patent regarding the surface temperature of the chilling unit in the warmer chamber. It has been common practice prior to applicants’ invention to cool a chamber to a low temperature well above the freezing point with a chilling element whose surface temperature is well below the freezing point, and the natural inference is that Anderson’s upper coil has a surface temperature below the freezing point. Certainly there is nothing in his specification to teach the contrary. Furthermore, Anderson’s chilling units are connected in series and no means are provided for maintaining a different pressure in the two chilling units, or for forming the upper chilling unit with a broad heat absorbing surface, such as would prevent the formation of frost thereon. It will be obvious to any one skilled in the art, that the coils in Anderson’s warmer chamber must have a surface temperature below the freezing point, either throughout the length of the coils, or through a substantial extent thereof, for if Anderson’s apparatus were so arranged that all of the refrigerant were evaporated in the lower chilling element, there would be little cooling effect left in the completely vaporized fluid

passing up through the upper coil, certainly not enough to cool the large upper food chamber adequately, particularly since the latter chamber is the one most frequently used and is constantly being opened for introduction of food thereinto, or the removal of food therefrom. Hence, it will be apparent to anyone skilled in the art that Anderson's coils in the upper chamber must be maintained at a surface temperature below the freezing point of water. The fact remains that Anderson does not anywhere in his specification teach the invention disclosed in the present application."

Thus, the implication is left, as it is in appellant's brief, that in Bronaugh & Potter there is no liquid refrigerant evaporating in the cooling coil, although the specification briefly mentions the contrary (col. 5, lines 7-12):

"The refrigerant will be completely vaporized in coil 22 until the temperatures of the compartments near said minima, when some of the refrigerant will reach the coil 25 *in liquid form, and by vaporizing therein, will cool compartment 14.*"

The fact is as established by the testimony of appellant's own witnesses that the patent and refrigerators operate the same as Anderson and everything said about the operation of Anderson's cooling coil is equally true of the corresponding coil in Bronaugh & Potter.

Unfortunately, in the ex parte proceedings in the Patent Office, such information was never elicited from Bronaugh & Potter. It is reasonable to believe that the patent would never have been granted if the Examiner had known that the sole grounds of distinction which had been urged between Bronaugh & Potter and Anderson was illusory.

The feeble distinction which appellant tries to make between Bronaugh & Potter and Anderson is not valid and contrary to the testimony of appellant's witnesses. Both patents have the same elements operating in the same organization to produce the same results. Appellant's cavalier treatment of the Anderson patent should be no more successful in this Court than it was before the Trial Judge.

**(B). In Stretching the Scope of the Claims in Suit in an Effort to Establish Infringement, the Claims Are Anticipated by the Davenport Patent No. 1,726,344.**

Some of appellant's admissions are as follows: Appellant's brief, page 15: "Each element in the combination was old in the art."

Appellant's expert admitted (R. 844-851) that the combination of all of the following old elements was old: A cabinet 10, a cooling compartment 14, a freezing compartment 12 and 13, thermal insulation 33, 39 and 41 surrounding each compartment, a section of pipe (expander) 25 extending through the cooling compartment 14, a section 22 of the same pipe (expander) extending through the freezing compartment, volatile liquid refrigerant in the pipe, an expansion valve 23 in pipe 22, a single unit 15 for liquefying the vapor formed in the pipe, and a thermostat 31 in the cooling compartment 14 for automatically controlling the operation of a motor 16.

At R. 850-851 appellant's expert testified:

"Q. Well, now, their being all old elements, the elements that I have mentioned all being old, then the grouping of elements—call it a combination of

elements if you will—is an old combination of old elements, is it not, insofar as the parts I have mentioned?

A. So far as you have mentioned them, yes.”

Appellant's expert admitted that the improvement made over Anderson was to provide the cooling coil with fins (R. 851-852).

Further statements with respect to the antiquity of the structure, function and results set forth in the claims of the Potter patent may be found in appellant's brief, as follows: Page 18 (lines 11-18), page 22 (lines 15-21), page 45 (paragraph beginning at bottom of page), and page 47 (second paragraph).

While making all of the above admissions, appellant in a shift from its original position during the trial that the improvement of Bronaugh & Potter was in providing the cooling coil 25 with fins, now states that the alleged improvement is as follows:

(Br. 19) *“The undisputed and decisive fact is that nowhere in the prior art, whether in the patents issued before the invention or in the contemporaneous actual practice, is there taught a unitary, direct expansion machine by which a single volatile refrigerant provides, at the heat-exchange surfaces, simultaneously and uninterruptedly, both below 32°F. and above 32°F. Temperatures.”* (Emphasis appellant's)

On pages 20, 22, and 25 of appellant's brief, similar statements of the alleged invention are repeated.

In changing its position, appellant has apparently completely overlooked the Davenport patent No. 1,726,344 (Def. Ex. 107), not cited by the Patent Office. It discloses a cold wall type of household refrigerator hav-

ing a freezing compartment D and a cooling or food storage compartment E, a cold wall freezing element *d* (see particularly Figs. 7, 8, 2 & 3) including spaced metal plates 11 and 12 between which the volatile refrigerant flows for creating a freezing condition in the freezing compartment D, a cold wall cooling element *e* for cooling the cooling compartment E (see Figs. 1 and 2), the cooling element (see Davenport p. 2, line 62) including "a long metal pipe or tube 9 coiled or disposed in substantially horizontal parallel stretches and secured to a metal plate or sheet 9a with which the coil has good thermal contact so that the plate 9a forming the lining of the back and top of the compartment acts as an efficient heat absorber." See also enlarged modification in Fig. 6. The freezing and cooling elements *d* and *e* are connected in series (see Fig. 1) and a single volatile refrigerant is forced therethrough by an electric motor operated pump or compressor B, just as in the patent in suit. In Davenport the heat-exchange surface of the freezing element *d* is smaller than the heat-exchange surface of cooling element *e* and accordingly they are differently proportioned.

With respect to the extended cooling element for the cooling compartment in Davenport, see page 3, lines 6 through 17 which read:

"From the above it will be apparent that even if the refrigerating element used to line the chamber from which heat is to be extracted is made of a thick heavy material so as to withstand successfully high pressures or the impact of heavy objects which might be stored in the chamber, the necessary contact area for heat removal to maintain ordinary refrigerating temperatures can be secured with an *extended refrigerating element* occupying not more



than ten per cent of the cubical volume of the compartment."

In fact as the specification states beginning on page 2, line 38:

"The invention relates especially to the form, extent, disposition and arrangement of the refrigerating elements, utilized to extract heat from the freezing compartment D and the food storage compartment E."

The heat-exchange surfaces of the freezing and cooling elements *d* and *e* are purposely differently proportioned and thereby balanced in this regard so that when the single volatile refrigerant is passed through those freezing and cooling elements *d* and *e*, the heat-exchange surface of the freezing element will be maintained at a temperature below 32°F. and the heat-exchange surface of the cooling element will be maintained at a temperature above 32°F. (ordinary refrigerating temperatures, page 3, lines 13 and 14), simultaneously and continuously.

It should be mentioned that the Davenport patent discloses a direct expansion type of freezing and cooling system wherein an expansion valve *i* is provided. The specification at page 2, line 35, refers to "a suitable throttling or expansion device *i* being interposed to control the rate of feed of the condensed refrigerant." While Davenport does not specifically mention a thermostat, obviously some such device (as disclosed in his companion patent 1,731,711, p. 1, lines 82-90) would be employed for controlling the operation of compressor B driven by electric motor C.



Attention is invited to a reading of the specification of this Davenport patent because there is too much to quote. However specific attention is invited to prior art teachings on page 1, lines 17 through 25:

“When the contact medium from which heat is absorbed is the atmosphere, it is common practice to *extend the contact area by various expedients such as fins, corrugations, tubes, coils, etc.*, as it is well known that a given quantity of heat can be absorbed from air with less temperature differences between the air and the element when the contact area is large than when it is relatively small.”

See also page 1, lines 50 through 60; lines 82 through 87; page 2, lines 10 through 68; page 3, lines 6 through 17; lines 28 through 37.

From the above it is clear that if the Potter claims are stretched to read on the accused structure, they read in identically the same manner on the disclosure of the Davenport patent. If the accused refrigerators are unitary machines adapted to operate simultaneously two balanced heat-exchange surfaces of differing proportions, one at below 32°F. (frosting) and the other above 32°F. (non-frosting) (Aplt's Br. 22), then the same is equally true of Davenport.

If the claims are construed to be infringed they are invalid for as said in *Knapp v. Morss*, 150 U.S. 221, 228, 37 L. Ed. 1059 (1893), and in many other decisions:

“that which infringes, if later, would anticipate if earlier.”

Approached in another way, attention is invited to claim 10 for example of this Davenport patent which reads as follows:

“In a closed cycle refrigerating system, a freezing compartment and a refrigerating compartment, and interconnected refrigerating elements arranged to contain vaporizing refrigerant and to extract heat from said compartment, one of said elements forming at least a part of the lining of its compartment.”

The Davenport patent was granted August 27, 1929. It expired and became public property on August 27, 1946, before appellees made and sold refrigerators. Despite this fact, appellant is making a desperate effort to reclaim as its monopoly that which was fully disclosed in the prior art and was a part of the public domain before appellees made and sold the accused refrigerators.

**(C). The Bronaugh & Potter Claims Are Invalid for Lack of Invention Over the Larkin Patent or Larkin in View of Anderson.**

Assuming that Anderson or Davenport do not completely anticipate Bronaugh & Potter we fail to see where they made any patentable advance over these prior art patents, particularly in view of the Larkin patent.

The Larkin patent No. 1,776,235 (Def. Ex. 106), which was not cited by the Patent Office, is a complete disclosure of a refrigerator using a volatile refrigerant and having a cooling compartment with coils 7, 8, 9 and 10 therein having fins or plates 12 for performing the same function and obtaining the same results claimed by Bronaugh & Potter.\* In the second paragraph of his

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\*The presumption of validity of Bronaugh and Potter is overcome by the fact that such pertinent references as Larkin and Davenport were not considered by the Examiner in the Patent Office. *Jacuzzi Bros. v. Berkeley Pump Co.*, 9 Cir., 191 F. 2d 632, 634; *R. Hoe & Co. v. Goss Printing Press Co.*, 2 Cir., 30 F. 2d 271, 274.

specification Larkin says his "invention relates to refrigeration in general and particularly to cooling units adapted for use in display case refrigerators, refrigerator cars, storage rooms, *household* refrigerators, etc."

The following is quoted from the Larkin patent, page 2, lines 113 through line 18 on page 3 (Def. Ex. 106):

"With the present type coil properly arranged in the casing, a temperature of 36 degrees F. can be maintained in the casing without frosting the plates at all, and consequently without freezing or dehydrating any of the contents of the casing whatever. The very large surface area and rapid heat absorption of the aluminum plates all lead to a rapid temperature drop when the unit is in operation. Since this temperature drop is less than two degrees, it follows that each refrigerating cycle of operation must be of very short duration, and consequently, must greatly reduce the amount of power required to maintain it in operation.

"Whatever little moisture may be picked up from the air in the casing is deposited on the plates; and, because of the large surface area of these plates, must when condensed, be spread on such plates in a very thin film, which is constantly being removed by the circulating air and returned to the air and meats from which it was taken.

"Where below freezing temperature must be maintained on the plates, as in prior coolers, it is obvious that any moisture taken from the meats become condensed and frozen on the plates and cannot be removed therefrom by the circulating air. In this case, the meats not only lose weight, which cannot be recovered, but also deteriorate greatly in quality.

"This maintenance of humidity is only one of the most important results flowing from the use of cooling coils designed as disclosed herein."

See also page 5, lines 88-105 of Larkin.

Larkin not only discloses a moist cold compartment in a mechanical refrigerator similar to that appellant argues Bronaugh & Potter disclose, but Mr. Bronaugh testified (R. 165, 166) that they had been using Larkin coils in commercial work and when they came to make up the patented refrigerator they actually used a Larkin coil.

The finned coil which Bronaugh & Potter placed in the cooling compartment of the old household refrigerator having both freezing and cooling compartments (Anderson) was the same old Larkin structure, performing the same old function, and producing the same old result, and no more (Aplt's Exp., R. 852-7; see quotation of testimony at pages 15, 16 above).

Appellant's witness, Mr. Quinn, confirmed that the existence and operation of fin coils for cooling purposes were old. He said (R. 684):

"Q. Well, of course, back there you say in 1925 or 1926 the fins were used for cooling surfaces, for increasing the cooling surfaces, and that well-known at that time—the function of fins—

Q. That principle was known a long time before that?

A. Well, I should think it would be obvious almost. Yes, the bigger the surface, the easier the contact with the air."

In this connection it should be noted that there is not a word in the specification of the Bronaugh & Potter patent that element 25 is a fin coil rather than the conventional tubular coil. This subject will be discussed later in the brief under the question of the sufficiency of the disclosure of the patent in suit.

Certainly Bronaugh & Potter did nothing beyond the skill of the ordinary mechanic in the refrigerator field.

To paraphrase the language in the *Great Atlantic & Pacific Tea Co. v. Supermarket Equip. Corp.* case, 340 U.S. 147, 153, 95 L. Ed. 162 (1950), the patentees here have added nothing to the total stock of knowledge, but have merely brought together segments of the prior art and claimed them in congregation as a monopoly.

The only reasonable conclusion from undisputed facts here is that the patent in suit lacks invention. The familiar language of the Supreme Court in the *A. & P.* case is applicable (340 U.S. 147, 152):

“Courts should scrutinize combination patent claims with a care porportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.”

See also the decisions of this Court in *Himes v. Chadwick*, 199 F. 2d 100 (1952); *Kwikset Locks v. Hillgren*, 210 F. 2d 483 (1954); and *Berkeley Pump Co. v. Jacuzzi Bros.*, 214 F. 2d 785 (1954).

In attempting to distinguish from *Larkin*, appellant states (Br., 15) that it is of the “flooded or float valve type” as contrasted to the “direct expansion system” of *Bronaugh & Potter* (Br., 5). Assuming this is so, although appellant’s expert, Mr. Parker, had no such diffi-



culty with the Larkin patent, it in no way reduces the efficacy of the reference. Larkin still uses a volatile liquid refrigerant, just like Bronaugh & Potter, whose flow is controlled by a float valve rather than an expansion valve into a fin coil, which in Bronaugh & Potter, according to Mr. Parker, was supposed to be the invention. Also, none of the Bronaugh & Potter claims limits the type of refrigerating system other than to one using a volatile refrigerant which applies equally to Larkin and Bronaugh & Potter.

Of course, even if the distinction appellant is attempting to make were material, it would not save the patent because, *undeniably, Anderson and Davenport 1,726,344 have direct expansion systems just like Bronaugh & Potter.*

Seldom does one find such literal appropriation of prior art devices and assembling of them by a patentee. Courts often, in finding lack of invention, discuss what the patentee did in terms of borrowing an element here and another element there and combining them to produce the expected or suggested result. However, usually in these cases, there has been no conscious borrowing from the prior art by the patentee. In our case it is admitted that conscious borrowing is precisely what the patentees did.

Nor can it be said that the defense of no invention, because of the disclosure of Anderson in view of Larkin, is improper. Anderson clearly shows the same organization of elements as Bronaugh & Potter and Larkin discloses a fin coil for precisely the purpose it was employed by Bronaugh & Potter and, in fact, Bronaugh & Potter used a Larkin coil in building their early refriger-



erators. We are therefore completely justified in considering these two patents together in determining whether or not Bronaugh & Potter made any patentable invention. (*Richmond Screw Anchor v. Umbach*, 7 Cir., 173 F. 2d 521, 532 (1949) ).

Certainly the addition of fins to the coil 40 of Anderson would not affect any element of the so-called "combination" other than the cooling chamber. Thus according to appellant's own testimony what Bronaugh & Potter did amounted to merely a modification or substitution of an element in an admittedly old combination. If patentable at all it would have to be for the element per se. This was impossible because Bronaugh & Potter merely used the coil previously patented by Larkin and purchased on the open market. (*Bassick Co. v. Hollingshead Co.*, 298 U.S. 415, 425, 80 L. Ed. 1251 (1936); *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549, 82 L. Ed. 1008 (1938) ).

**(D). The Bronaugh & Potter Claims Are Invalid Because They Cover a Mere Aggregation of Old Elements.**

The undisputed facts here can lead to but one reasonable conclusion, namely, that the Bronaugh & Potter claims cover admittedly old elements, each of which performs its old function with no new or surprising results. The whole does not exceed the sum of the parts. The cabinet, the cooling compartment, the freezing compartment, the insulation, the expanders (coils), the refrigerant, the expansion valve, the liquefying unit, and the thermostat, were all old, *and were old in combination as shown in the Anderson patent* (Aplt's Exp., R. 844-50). Each of these old elements performed the same old

function and obtained the same old results when placed in the box disclosed by Bronaugh & Potter (Aplt's Exp., R. 844-50). Even if Larkin fins, which Bronaugh & Potter did not mention, may be incorrectly added to their disclosure, the result is the same because these fins were also old, and performed the same old function and obtained the same old result (Aplt's Exp., R. 852-3).

The only reasonable conclusion that can be drawn from the testimony of appellant's expert is that the whole does not exceed the sum of the parts. The Trial Court properly reached this conclusion (R. 73).

Under the test laid down by the Supreme Court in the *A. & P.* case (340 U.S. 147, 151), the claims are clearly invalid.

"The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549: 'The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.' To the same end is *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U.S. 350, and *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84. The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that

the lower courts scrutinized the claims in the light of this rather severe test."

The Seventh Circuit's appraisal of the alleged Potter invention in *Refrigeration Patents Corp. v. Stewart-Warner Corp.*, 159 F. 2d 972, was as follows:

(p. 976) "Appellees' argument continues: 'As to the law cited by defendant . . . that the claims are for an exhausted combination and void as claiming more than what was invented, we have shown that the invention was not in a particular element but *in a new combination of elements which cooperated to produce new results.*'

"We cannot view appellees' stride in the refrigerator art with such enthusiasm—there was here no *new* combination of elements. There was at best an old combination with some of the elements somewhat varied, such as a finned coil; or an additional element added, such as a 'thermosensitive means in one of the compartments for controlling said refrigerating means;' or a duplication or aggregation of old elements, such as the two separated insulated compartments in the box, instead of one old insulated compartment."

(p. 978) "Element 6, appearing in claim 10 only, does present a more serious question. It is a 'non-frosting coil in the cooling compartment.' It is this non-frosting coil which saves the housewife the chore of repeated defrosting of the box, with some possible inconvenience and possible spoilage of foods, especially frozen foods. However, here again we have only a claim of a *result* without the statement of the *means* whereby that result is to be obtained. Nowhere in the specifications or drawings is a special kind of coil shown whose structure, such as finning, might be a frost collecting deterrent. Indeed, it was agreed by the experts of all parties that a coil may be non-frosting when it is operated in one way and become frosted if operated

in another way. Clearly, the non-frosting coil is the result of the combinations upon which plaintiffs seek to sustain the patents." (Emphasis Court's.)

*U. S. Air Conditioning Corp. v. Governair Corp.*, 10 Cir., 216 F. 2d 430 (1954), is a pertinent case involving combination type mechanical claims on a unitary air conditioning system. The factual situation is very close to ours in that the claims called for elements like those present in the Bronaugh & Potter claims. The Court of Appeals reversed the District Court and held the patent invalid on the basis of aggregation of old elements and the mere carrying forward of an old idea which involved no more than a change in form, proportion or degree.

Appellant, recognizing that the courts have set certain standards of invention, particularly for mechanical combination type patents, as mentioned in the *Berkeley Pump*, *Packwood* and *Nachtman* cases (*supra*), repeats (Aplt's Br., 7, 25, 37) that the combination of elements in the Bronaugh & Potter patent define patentable invention because the elements in combination operate differently to produce a new result, viz., a single refrigerator having "below freezing in one compartment and moist cold in the other" (Aplt's Br., 25).

Even if Anderson and Davenport did not disclose the patented combination, and contrary to appellant's repeated denials, Bronaugh & Potter did no more than assemble in one cabinet the admittedly existing freezing compartment with the admittedly existing moist cold compartment to produce a single refrigerator having a freezing and a moist cold compartment. One and one still make two.

(E). The Bronaugh & Potter Patent Is Invalid Because There Is an Entire Absence of Written Description of the Alleged Improvement or Advance or Change Consisting in Providing an Old Cooling Coil with Fins and Therefore There Is Lack of Compliance with 35 USC 112.

Section 112 of 35 USC reads:

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

“The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claims shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

On cross-examination appellant's expert admitted that the alleged Potter improvement was in providing the cooling coil with fins. He testified:

“That is the change he made.” (R. 852)

If that is the change or advance or alleged invention that was made, certainly it would be expected that it would be described in the specification because of the mandatory requirements of the above statute.



A reading of the patent specification clearly establishes that not a single word is said about a fin or a cooling coil having a fin for performing any function whatever. Nor is any equivalent structure described to perform the function of fins in the patent. Appellant's expert, on cross-examination, admitted this fact (R. 864). Under such circumstances the patent is clearly invalid.

In connection with this point attention is invited to the much cited decision in *Permutit Co. v. Graver Corporation*, 284 U.S. 52, 76 L. Ed. 163 (1931).

(p. 57) “\* \* \* There is no mention in the specification of either a ‘free’ or a ‘locked’ zeolite bed; or of the alleged discovery that a rising space above the zeolite bed is necessary for the successful operation of the softener; or of the need of a device to prevent the lighter grains of zeolite from passing out in back washing. Nor does Claim 1 or Claim 5 make mention of a ‘free’ zeolite bed. Claim 1 is for ‘a filter bed consisting of a layer of sand or quartz and a layer of zeolite or hydrated alumino-silicates disposed on the layer of sand or quartz.’ Claim 5 for ‘a filter bed consisting of a layer of zeolites or alumino-silicates, supporting means for said layer.’ As the patentee has thus failed to give in the specification ‘a written description’ and has likewise failed particularly to point out and distinctly claim the free zeolite bed, as ‘the part, improvement, or combination which he claims as his invention or discover,’ the patent is void.”

Appellant's expert in the case at bar testified that the rectangular outline designated 25 in Fig. 2 of the patent in suit represents, in his opinion, a fin (R. 759). Assuming such to be a fact, it would be of no avail where there is an entire absence of description of the alleged in-



vention. See page 60 in the same *Permutit v. Graver Corporation* decision where the Court states:

“Moreover, while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claims, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it.”

See also *Foxboro v. Taylor Investment*, 2 Cir. 157 F.2d 226 (1946):

(p. 232) “. . . but the interpretation becomes doubly impossible when we remember that no invention can be saved by features which appear only in the figures and are not mentioned in the text” (citing *Permutit* case).

It is submitted therefore that the patent is invalid because it does not meet the requirements of the statute which demands that the specification shall contain a written description of the invention in full, clear, concise and exact terms. Here there is an entire absence of a description of a fin coil which plaintiff's expert testified was the change which the patentees made.

In addition, the claims are invalid because they are improperly functional in a manner to violate the requirements of Section 112 of 35 USC. The claims call only for a result at the point of alleged novelty. For example, the claims specify “a cooling refrigerant expander having heat-conducting surfaces within the cooling compartment and constructed and arranged to maintain its heat-conducting surfaces at a temperature above 32°F. while withdrawing heat from said compartment.” This is not a definition of structure. It is a statement of function. The last sentence in the above quoted section 112 does not save the claims because there is no description in

the specification of the structure involved in "constructed and arranged."

Again, the specification and claims violate Section 112. There is no written description whatever of the fins which appellant's expert said were the only change over Anderson. The description and claims are indefinite and vague. Foundation for the claims is lacking in the specification. *Schriber-Schroth Co. v. Cleveland Trust*, 311 U.S. 211, 214, 85 L. Ed. 132 (1941); *Permutit Co. v. Graver Corporation* (supra); *Refrigeration Patents Corp. v. Stewart-Warner Corp.* (supra); *National Theater Supply Co. v. Da-Lite Screen Co.*, 7 Cir., 86 F. 2d 454, 455 (1936).

**(F). The Patent in Suit Does Not Satisfy the Criteria and Standards Established by This Court for Patentable Invention.**

The foregoing discussion of the Potter patent, the prior art, and appellant's own testimony, establish:

1. All of the Potter elements are admittedly old. Potter admittedly did not invent moist cold refrigeration, or a finned coil, or a "non-frosting" coil, or a household refrigerator with two compartments, one for freezing foods and the other for cooling foods. These were all well known in the art prior to Potter.

2. If, as appellant's expert contended (R. 852), the only change which Potter made over Anderson was in adding old fins to the old cooling coil, these fins which were "stock items" (Aplt's Br. 46), gave no new or surprising results in the Potter cooling compartment. They had long performed the same function and given the same results in refrigerator cooling compartments.

3. If, as appellant contends in its brief here (p. 22), the alleged Potter invention is "a unitary machine with such device (i.e., a single volatile refrigerant device) to operate simultaneously two balanced heat-exchange surfaces of differing proportions, one at below 32°F. (frosting) and the other at above 32°F. (nonfrosting) . . .," then the prior Anderson and Davenport patents meet the Potter structure, element for element, and are anticipations. The Anderson and Davenport heat-exchange surfaces operate above 32°F. and are "nonfrosting" in the same sense as Potter's. In each machine (Anderson, Davenport, Bronaugh & Potter), the adjustment of the adjustable expansion valve, as was well known, determines the rate of evaporation in and the temperature of the cooling coil, and the degree of "frosting" of the coil.

4. On either of appellant's theories as to what constitutes the alleged invention, each of the old elements in the Potter box performs its old, well known function and gives its known, expected results—and no more. The fins give better heat transfer, just as they had for years in cooling compartments. The expansion valve had long been adjustable so as to regulate the flow of refrigerant to control the rate of evaporation and the resulting temperature of the coil.

On either of appellant's theories, Potter does not meet the standards of invention.

*Berkeley Pump Co. v. Jacuzzi*, 214 F.2d 785, is particularly pertinent because the facts in that case were much more favorable to the patentee than they are to Potter. This Court described the device there involved as follows (p. 789-91):

"In his testimony Carpenter (the patentee) frankly stated that he laid no claim to invention of any of the parts or elements incorporated in his Berkeley pump. His position is epitomized in the claim that his invention is 'the complete concept of the entire system \* \* \* what it will do, and how it does it.' This boils down his argument to the end product of integration. \* \* \*

"One unpatented combination pump (known as the 'Advance Pump') bore a marked similarity to the Berkeley pump, although it preceded application for a patent on the Berkeley pump by a half-dozen years. This 'Advance Pump' used a jet device to raise the water to the top of the casing, instead of using staged turbines. \* \* \*

"\* \* \* It was the use of the jet method of raising water from the well which kept the 'Advance Pump' from being sufficiently efficient to perform both high and low pressure functions simultaneously.

"Substantially all that was needed, however, to provide the needed 'dual' capacity to convert the 'Advance Pump' to the Berkeley pump in suit was to use turbine impellers to raise the water in the well, instead of the jet-type of construction it employed.

"There was absolutely nothing new in the pump art about turbine impellers. \* \* \*

\* \* \*

"Like the 'Advance Pump', the Berkeley pump is essentially two pumps, arranged in sequence: one a deep-well turbine type pump to bring the water to the surface into a chamber, and the other a shallow-well type high-pressure pump to pump a small part of that water at high pressure. (The larger part of the water brought to the chamber is permitted to flow out at low pressure for irrigation purposes, without going through the high-pressure pump.)

\* \* \*

"As indicated above, it has never been the assertion of appellant that any of the elements combined in its pump are original. It is admitted that essentially the Berkeley pump consists of two separate pumps operated from a single motor. The first pump raises water from a deep well and creates a pool of water in the low-pressure discharge chamber. The second pump operates in its usual manner, as a high-pressure shallow-well pump, and the 'shallow-well' upon which it operates is the pool of water collected at the surface in the discharge chamber. It is this combination of two pumps, arranged to operate with a single motor so as to make available simultaneously a large volume (100 to 300 gallons per minute) of low pressure (one pound per square inch) water for irrigation, and a small volume (about twenty-five gallons per minute) at high pressure (twenty pounds or more per square inch) for household use.

"The Berkeley pump is a clever and useful design, and the original combination of the two pumps is the claimed invention. It is claimed that this pump produces a new and beneficial *result* by means of a *new mode of operation*. However, the testimony of Mr. Carpenter, President of the appellant, is clear that the only new result produced is the simultaneity of both high and low pressure pumping, for the anticipating 'Advance Pump' could, without that particular attribute, pump either high or low pressure water. And the only substantial difference between the 'Advance Pump' and the Berkeley pump is the substitution of turbine impellers for a jet type pump. His testimony also makes it clear that neither of the two pump elements used in the Berkeley pump operate in any different manner, nor do they accomplish any new or different result or purpose, than they did prior to their inclusion in the Berkeley pump. These two elements are used for exactly the same operation, and accomplish exactly the same purpose as they previously did. The mere *arrange-*



ment of the two pumps in a manner similar to the 'Advance Pump' arrangement, is insufficient to bring the device within the orbit of patentable invention under the A. & P Tea rule we have noted."

In affirming a judgment for defendant entered on a directed verdict, this Court said in the same case as to the standard of invention, page 787:

"... it should be pointed out that we are here dealing with a mechanical device which concededly involves only a combining of old elements all of which were well known in the prior pump art. Under the pleadings the most vital question to be answered is whether the Berkeley combination in suit constitutes a patentable invention.

"In a recent decision, *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 1950, 340 U.S. 147, 71 S. Ct. 127, 130, 95 L. Ed. 162, hereafter referred to as *A & P Tea*, the Supreme Court considered and disposed of the problem of what sort of combinations the lower courts are free to regard as patentable inventions in the mechanical field. In this decision it established the criteria and standards which must now be applied in determining whether a combination patent is valid. In *Kwikset Locks v. Hillgren*, 9 Cir., 210 F.2d 483, 486, certiorari denied, 347 U.S. 989, 74 S. Ct. 852 we commented on and applied the standard approved by the high court, and the rule we followed in *Kwikset* is applicable to the facts of the instant case. Therefore we have examined the record on appeal to determine whether or not it clearly establishes that the Berkeley device meets the rigid standards of invention we must apply, in default of which it must be regarded as an example of mechanical skill in assembling old elements *the previous functional operations* of which are not changed by their arrangement and inclusion in the device. \* \* \*"



The recent decision of this Court in *The Coleman Co., Inc. v. Holly Manufacturing Co.*, 233 F.2d 71 (1956), much relied upon by appellant (Br. 34-7), is plainly distinguishable on the facts, and Potter clearly does not satisfy the standards of invention there enunciated by this Court.

Four elements in the patented structure in the *Holly* case were new. This Court further found that "a 'heat exchanger' or 'economiser' of this particular construction and arrangement had never been embodied in any type of mechanical wall heater apparatus prior to its application and use in the *Holly* device" (233 F.2d 79).

This Court stated the test to be whether "an 'element' in the *Holly* device . . . will (to quote the Supreme Court) 'perform any additional or *different function*' (i.e., a special purpose) when brought into concert with the other elements in the combination than it would perform out of it." (Court's emphasis.)

The Potter patent does not meet that test, since the old freezing compartment and the old cooling compartment perform the same in the combination as out of it.

In *Hansen v. Safeway Stores*, . . . F. 2d . . . , 110 USPQ 170 (June 27, 1956), recently decided by this Court, the patented structure embraced four elements, which the Court of Customs and Patent Appeals had previously held constituted a patentable invention. This Court held that "there was sufficient evidence to raise a question of fact as to whether the Hansen patent performed a new and useful function by a combination of these elements known in the prior art."

In the case at bar, the only reasonable conclusion that can be drawn from the plaintiff's own evidence

(particularly the testimony of Parker, Bronaugh, and Bade) is that in Potter there is no new function.

The Potter patent does not meet the standard of invention prescribed in the *Hansen* case.

Admittedly Potter does not differ from the prior Anderson patent in structure, nor can Potter distinguish the operation of his refrigerator from Anderson who also has an adjustable expansion valve. The handle on the valve 33 in Anderson (see Figs. 1 and 2) is for the very purpose of manual adjustment by the user to regulate the rate of flow of the refrigerant in the freezing and cooling coils. Potter provides a corresponding handle or knob on his valve 23 (see Fig. 1).

It is submitted that the Anderson structure is a complete anticipation, and that in any event, the adjustment of an adjustable part does not meet the standards of invention of this Court.

It is well settled that a mere change in form or adjustment, manifesting a difference in degree only, is not invention. *Palmer v. Kaye*, 9 Cir., 185 F.2d 330, 332 (1950).

**(G). The Claims of the Bronaugh & Potter Patent Are Invalid for Late Claiming.**

All four of the Bronaugh & Potter patent claims must, according to appellant, call for a "nonfrosting" coil.\* As explained in the foregoing argument, appellees deny that there is any such thing, but if there is, then these claims

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\*Appellant's brief, page 51, next to last line, states: "What was essential to the invention, and was amply disclosed in the specification, was a *non-frosting coil* which could be either a finned coil or any other type of extended surface coil such as a brine tank."

are invalid since they were not filed within the two-year statutory period relating to public use or sale, then in force (old R.S. 4886 changed to one year Aug. 5, 1940), now 35 U.S.C. 102.

The first mention, in either the specification or the claims of the original Bronaugh & Potter patent 2,056,-165, of which the present patent is a reissue, of a "non-frosting" coil, was on December 2, 1932 (file wrapper, Def. Ex. 101, pp. 25-26).

Mr. Bade testified that a refrigerator known as the "Barry box" was constructed around April or May, 1930 (R. 198), and that it was sold to Mr. Barry in June, 1930 (R. 200). This refrigerator and other refrigerators made at that time were constructed in accordance with the principles of the Bronaugh & Potter invention (Potter, R. 326, 328). Mr. Bade also testified that this Barry Box had differential insulation around the two compartments and a fin coil in the refrigerating compartment (R. 201).

The sale of the Barry Box establishes that there was public sale more than two and a half years prior to the assertion in the Patent Office of the subject matter claimed (non-frosting coil).

With respect to the so-called proportionate or differential insulation appearing only in Claims 3 and 4<sup>†</sup> of

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<sup>†</sup>Commercially (Bommer, R. 577-78) and as shown in the prior patents (see for instance Davenport 1,769,118, Fig. 1, "additional insulating material 19"), proportionate or differential insulation was old. Proportionate or differential insulation in this case is another way of saying difference in heat leakage into the freezing and cooling compartments. Of course Anderson shows such difference in heat leakage because of the disproportionate wall areas of his freezing and cooling compartments (Apl'ts Exp., R. 860-861).

the Bronaugh & Potter patent, the subject of late claiming, as applied to the original Potter patent (2,056,165) was considered in *General Electric Company v. Refrigeration Patents Corp.*, 71 USPQ 236 (W.D. N.Y. 1946). In connection with Claim 11 of the original patent, the Court held that the claim was invalid because it was inserted in the patent more than two years after the subject matter was first publicly used and sold. The first mention of "proportionate or differential insulation" was inserted in the application of the original Bronaugh & Potter patent by an amendment dated January 29, 1934 (Def. Ex. 101). This, of course, was more than two years after the sale of the Barry box in June of 1930.

All of the claims of the Bronaugh & Potter patent are invalid for late claiming on the basis of *Muncie Gear Works v. Outboard Marine & Mfg. Co.*, 315 U.S. 759, 86 L. Ed. 1171 (1942), and *General Electric Company v. Refrigeration Patents Corporation* (supra).

### III. THE CLAIMS OF THE BRONAUGH & POTTER PATENT ARE NOT INFRINGED.

(A). The Accused Refrigerators Are of the Cold Wall Type Whereas the Refrigerator of the Patent in Suit According to Appellant's Witnesses Is of the Finned Coil Type. Admittedly They Are Different in Structure, Function and Result.

Each of the four claims in suit contains the following element:

"a cooling refrigerant expander having heat-conducting surfaces within said cooling compartment and

constructed and arranged to maintain its heat-conducting surfaces at a temperature above 32°F. while withdrawing heat from said compartment,

whereby air in said cooling compartment is cooled thereby to a temperature above 32°F. and is maintained at a humidity whose relative value is at least 100% at 32°F.”

Applied to the patent in suit, the cooling compartment is shown at 14. The cooling refrigerant expander (coil) is shown at 25. This expander (coil) 25 and its heat-conducting surfaces are within the cooling compartment 14 (Aplt's Exp., R. 888). The cooling expander (coil) 25 is constructed allegedly to have fins (not described in the specification and of doubtful showing in the drawings) to maintain the heat-conducting surfaces thereof above 32°F. while withdrawing heat from said cooling compartment 14.

The Potter refrigerator of the patent in suit is what is known as the finned coil type of refrigerator or arrangement (Aplt's Exp., R. 903).

Appellant's expert, Mr. Parker, also testified (R. 903) that the accused refrigerator is what is known as a cold wall type of refrigerator which is structurally and functionally different from the finned coil type (R. 903). He again stated that the finned coil type of refrigerator as exemplified by the patent in suit and the cold wall type of refrigerator as exemplified by the accused refrigerator are structurally different and are two separate types (R. 910).

Potter's copatentee, Mr. Bronaugh, testified that they also explored the cold wall idea and because of the adverse results they obtained, they abandoned the cold wall idea and “devoted our entire efforts from there on to the finned coil concept of cooling that fresh foods compartment” (R. 128).



Therefore it is established by appellant's witnesses that the cold wall type of refrigerator exemplified by the accused refrigerator and the finned coil type of refrigerator as exemplified by the patent in suit differ in structure, in functioning and in results. Clearly there can be no infringement.

But now let us explore the fantastic efforts of appellant's patent expert in attempting to apply this above quoted claim element to the accused refrigerator. In his attempt we submit it will become apparent that he exercised a super imagination which drifted far beyond the realms of reasonableness and logic.

Of course it is well understood that patent claims must be read in the light of the disclosure of the patent and that the claims cannot be construed more broadly than the alleged invention (*Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510, 61 L. Ed. 871 (1917) ).

In the first place, it is clear that the cooling compartment 14 in the patent is the space in which food is stored. The specification calls it "a food storage compartment." The cooling expander (coil) 25 and its heat-conducting surfaces are within this cooling compartment 14 and as a result thereof appellant correctly states that an air circulation is set up in the cooling compartment 14 because warm air is drawn to the coil 25 and the relatively cooler air takes its place. The asserted advantage as a result thereof is that mold will not form on the food in the cooling compartment.

Appellant's expert witness admits that the accused refrigerator does not have any finned coils in the cooling chamber. At R. 859 he testified:



"Q. Well, now, Admiral does not have any finned coils in the cooling chamber, does it? A. No."

At R. 1371 he also testified:

"Q. Now, the cooling coils in the accused structure are not within the cooling compartment in so far as the space in which the food is placed, is that correct?

A. That's correct."

To comprehend what the application of this claim element by appellant's expert witness is, attention is invited to Plaintiff's Exhibit 8A (Appendix Plate V).

At the left there is shown a rear perspective view of the cooling compartment B with the cooling coil D wrapped around the outside back and side walls thereof. At the top of the outer back wall there is a horizontally arranged oblong cold plate G known as a secondary transfer plate. Lying between the outside back wall and the plate is a portion of the outside cooling coil and that portion is the condenser portion of the cooling coil because as will be pointed out later, the vaporized refrigerant is recondensed therein preparatory to its passing down through the vertical tube portion and then laterally outwardly in opposite directions and upwardly to complete the circuit. It will be appreciated that the liquid volatile refrigerant in passing through this cooling coil absorbs heat from the cooling compartment and in so doing vaporizes and then is recondensed in the condenser portion of the cooling coil.

At the right hand side of the exhibit there is shown a freezing compartment A at the top. Around the outside of the top, bottom and one side wall of this freezing compartment the freezing coil C is wrapped. A portion of the

freezing coil is attached to another horizontally arranged oblong plate H known as the primary transfer plate. When the parts are assembled the primary transfer plate H and the secondary transfer plate G are secured to each other as a result of which the primary transfer plate which is reduced in temperature by the zero degree liquid refrigerant passing through the attached freezing coil, lowers the temperature of the secondary transfer plate. This in turn recondenses the refrigerant vapor as it passes through the condenser portion of the cooling coil attached to the secondary transfer plate.

In attempting to apply the claim element in question, the position of appellant's expert witness Mr. Parker was:

1. That the accused cooling coil although it is wrapped around the outside wall of the cooling compartment, is within the cooling compartment because it is located within the insulation surrounding the cooling compartment.

At R. 890 he testified:

"... to me everything that is within the refrigerated space surrounded by the insulation about the cooling compartment is within the cooling compartment."

2. That the "cooling refrigerant expander (coil) having heat-conducting surfaces within the cooling compartment" is found in the accused refrigerator because the inner walls of the liner of the cooling compartment are regarded as the heat-conducting surfaces of the expander (coil) which is outside of the liner or walls of the cooling compartment, and the cooling refrigerant expander (coil) is regarded to be the coil outside of the liner

or cooling compartment, plus the secondary transfer plate, plus the primary transfer plate, plus the section of the freezing coil engaging the primary plate (R. 810-11).

Thus plaintiff's expert witness, Mr. Parker, said that cooling coil 25 located in the cooling compartment 14 of the patent in suit and as set forth in the claim element in question, in the accused refrigerator is the cooling coil on the outside of the liner or cooling compartment, plus the secondary transfer plate, plus the primary plate, plus the freezing coil section engaging the primary transfer plate of the accused refrigerator; also that the inner surfaces of the liner or cooling compartment in the accused refrigerator constitute the heat-conducting surfaces or fins on the cooling coil 25 in the cooling compartment 14 in the patent in suit (R. 810, 811). See Mr. Parker's testimony at R. 810 and 811 as follows:

"To go back to the beginning of it, 'a cooling refrigerant expander having heat-conducting surfaces within the cooling compartment.' The transfer plate—the primary transfer plate about which I have testified and which is marked 104 on Plaintiff's Exhibit 8-A-1 is the only means for abstracting heat from the secondary or the moist cold compartment. Its heat transfer — its heat-conducting surfaces within the cooling compartment are the actual heat-conducting surfaces of the liner itself which conducts heat to the expander on the primary plate 104."

Mr. Parker then said (R. 812):

"It's a long way of saying that a moist cold is maintained in the moist cold storage compartment."

Then to add more confusion to confusion, appellant's expert stated that contact plates, namely the primary transfer plate and the secondary transfer plate, act as

fins (R. 799) or in other words cooling coil heat conducting surfaces.

Appellant's expert, referring to the cooling coil or expander, stated at R. 887:

"A. Expander is any member in which a refrigerant, and to me the term includes the duct itself and whatever conducting surface it has which carry heat to the duct."

Also at R. 895 he said:

"To me the expander, term 'expander' in those claims means that pipe plus whatever heat exchange surfaces are attached or connected to it."

3. Another position taken by appellant's expert in applying the claim element to the accused refrigerator and which he emphasized was that the section of the freezing coil which is secured to the primary transfer plate is a part of the cooling refrigerant expander (R. 895).

Also at R. 1371 Mr. Parker testified:

"Q. Now, then, you have also stated, I believe, that the cooling expander or coil or duct, part of it is found on the, attached to the plate of the primary transfer plate of the primary system; is that correct?

A. That is true."

Mr. Parker testified (R. 895-896):

"Q. Is there a condition in the operation of this accused device when the freezing refrigerant passes through the coil attached to the primary plate and also passes through the coils around the freezing compartment?

A. Surely.

Q. O.K. Then under those conditions at that time the freezing refrigerant passing through that freezing coil is about zero degrees Fahrenheit, is it not?

A. It is, yes.

Q. Now, then, it is said, and you agreed, that that portion of the freezing coil attached to the primary transfer plate is a part of the cooling system for the cooling compartment.

A. That's correct.

Q. All right. Now, I am talking about that part. This is what the claim says: 'A cooling refrigerant expander constructed and arranged to maintain its heat-conducting surfaces,' and it has heat-conducting surfaces there (indicating)?

A. Yes.

Q. 'To maintain it at a temperature above 32 degrees Fahrenheit.' Now, that's an impossibility, is it not?

A. *That particular part of the expander does not have those characteristics."*

It is clear from the above that the position which appellant's expert, Mr. Parker, has taken in attempting to apply the claim element in question to the accused refrigerator is unrealistic, forced to an absurdity and stretched far beyond the elastic limit.\*

That claim element when properly construed means that the cooling expander or coil 25 is within the cooling compartment or liner 14; that the cooling coil heat-conducting surfaces or fins (not described in the specification and of doubtful showing in the drawings) are located within the cooling compartment or liner; that the cooling compartment 14 means the liner in which the food is stored. The claims are limited to the finned coil type of refrigerator and most certainly cannot be extended to the cold wall type of refrigerator. The two

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\*As the Court said in the well known case of *White v. Dunbar*, 119 U.S. 47, 51, 30 L. Ed. 303 (1886), a claim is not "like a nose of wax which may be turned and twisted in any direction" so as to make it include more or less than its words express.



types are admittedly different in structure, operation or functioning and results. In the accused refrigerator the appellant insists that the freezing coil attached to the primary transfer plate which is cooled to zero degrees F. is included in the cooling coil, however this is impossible since the patent claim requires maintaining the heat-conducting surfaces of the cooling coil above 32°F.

For the reasons above given, among others, it is clear that the Trial Court had sound and ample reasons of record for holding the claims not infringed.

**(B). The Accused Refrigerators Have Two Liquefying Units With Two Separate and Distinct Refrigerants Rather Than a Single Liquefying Unit and Refrigerant as Called for in the Claims.**

Each of the four claims of the Bronaugh & Potter patent call for:

“volatile refrigerant in said expanders, a single liquefying unit associated with said expanders . . .”

There is only a “single” volatile refrigerant (Aplt’s Br., 22, third line, first paragraph) in the Bronaugh & Potter system and it is the “same” one which is evaporating in both expanders (freezing and cooling coils) (Aplt’s Br., 26, second line, second paragraph).

As pointed out in the factual statement, page 17 above, the accused refrigerators have two separate and distinct refrigerant circuits, two separate and distinct supplies of refrigerant and two separate and distinct liquefying units. Appellant’s expert agreed that there are two liquefying units. He testified (R. 928):

“Q. So that in the accused refrigerators there is a liquefying unit in the freezing expander circuit,



and there is another liquefier or condenser in the cooling expander circuit?

A. Yes."

In the file history (Def. Ex. 102) Bronaugh & Potter emphasize the meaning of "a single liquefying unit," for on page 57 they say:

"A single condenser condenses refrigerant expanded by heat extracted from the compartments, which heat flows from one compartment to the other and thence to the condenser."

The accused two-circuit system is of the type shown in the Gibson reissue patent No. 21,941 (Def. Ex. 111), and G. A. Gase et al patent No. 1,371,235 issued March 15, 1921 (Def. Ex. 112), as distinguished from the single circuits of Anderson, Davenport and Bronaugh & Potter.

The accused refrigerators similarly have two separate circuits, one a freezing circuit and the other a cooling circuit in which separate and distinct volatile refrigerants flow through said circuits, one refrigerant flowing through the primary freezing coil only for extracting heat from the freezing compartment, and the other refrigerant passing through the cooling coil only for extracting heat from the cooling compartment.

Appellant's engineering witness, Mr. Bommer, a refrigeration engineer and a former chief engineer of one of Potter's companies, testified that a system having a primary freezing circuit and an independent secondary cooling circuit is distinctly different from a system such as disclosed in the patent in suit wherein the freezing pipe and the cooling pipe are in one continuous circuit and in which a single refrigerant flows (R. 640-41).

Accordingly, since the accused refrigerators have two refrigerants and two liquefying units they can not infringe the Bronaugh & Potter claims, which call for a single refrigerant in a single liquefying unit.

In neither their original application nor reissue application did Bronaugh & Potter claim the accused type. Instead, they deliberately claimed the single circuit type shown in their drawings and in Anderson. The accused refrigerators plainly do not respond to the claims and do not infringe. This is the only reasonable conclusion from plaintiff's own evidence.

A judgment n.o.v. was proper here on the ground of non-infringement.

**(C). There Is no Identity of Structure, Function and Result.**

The accused refrigerators are of the "cold wall" type (Def. Ex., 107; Davenport 1,726,344) in which the refrigerant pipes are on the outside of the compartments and there are two separate and distinct refrigerating circuits for refrigerating the respective compartments as distinguished from the single circuit of the Bronaugh & Potter patent.

In order for there to be infringement there must be, as between the accused structure and the patented one, an identity of structure, function (mode of operation) and result. Of course it is recognized that even if the refrigerators of plaintiff and defendants attain the same result, there is no infringement if defendants attain the results by different means and in a different way. *Electric Ry. v. Hall*, 114 U.S. 87, 29 L. Ed. 96 (1885); *Grant v. Koppl*, 9 Cir., 99 F. 2d 106 (1938); *Brown & Sharpe v. O. S. Walker Co.*, 1 Cir., 167 F. 2d 687 (1948).

**(D). The Claims in Suit Are Not Entitled to a Liberal Construction Because the Alleged Invention, if Any, Is Exceedingly Narrow.**

At most, Bronaugh & Potter made a narrow, limited, alleged "improvement" in a crowded field. Anderson and Davenport make that clear as do the file wrappers of the prosecution of the Bronaugh & Potter applications (Def. Ex. 101, 102). Accordingly, the claims are to be strictly construed. *Overlin v. Dallas Machines & Locomotive Works*, 9 Cir., 297 Fed. 7, 10, 11 (1924); *Magnavox v. Hart & Reno*, 9 Cir., 73 F. 2d 433 (1934); *Danforth v. Northill Co.*, 9 Cir., 142 F. 2d 51 (1944).

**(E). If the Bronaugh & Potter Invention Is for What Appellant Said It Was in the Trial Court There Is no Infringement.**

Throughout the trial below appellant's witnesses emphasized the presence and importance of a fin coil rather than a plain pipe or coil in the Bronaugh and Potter cooling compartment, as shown from the following partial record references (R. 277, 278, 280, 282, 312, 326, 327, 328, 331, 430, 508, 509, 515-518, 601, 624, 852, 853). Indeed appellant's expert Parker unequivocally testified that the improvement Bronaugh & Potter made over Anderson was the provision of finned coils (R. 852).

In the light of appellant's own evidence, the expression "a cooling refrigerant expander having heat conducting surfaces within said cooling compartment and constructed and arranged to maintain its heat-conducting surfaces at a temperature above 32°F. while withdrawing heat from said compartment" which appears in all of the claims of the patent means a *fin coil* which is

a particular type of coil. It is undenied and undeniable that the accused refrigerators have only *plain pipes or coils*, like those in the Davenport patent (Def. Ex. 107) and therefore there is no infringement.

#### IV. NEITHER THE POTTER REFRIGERATOR NOR THE POTTER PATENT MADE ANY IMPACT ON THE PUBLIC OR THE REFRIGERATION INDUSTRY.

Appellant's brief (pp. 28-30) attempts to make a showing of commercial success for the refrigerator manufactured by Potter's companies. However, a careful reading of that section of appellant's brief emphasizes that the Potter box was a commercial failure.

Appellant first recites (pp. 28-29) a few historical facts about isolated sales of two Potter refrigerators, one to Barry and one to McChesney; Potter's move to Buffalo in 1932, and his announcement to the trade. None of these facts show any commercial success or public acceptance.

Further, appellant asserts (p. 29) that General Electric and Frigidaire were "sensitive to the Potter accomplishment"; that Kelvinator made "abortive attempts at two climate food storage"; that Bommer came with the Potter company because of "the potential of the invention"; and that authorities wrote "of its promise". These vague recitals do not show commercial success.

Appellant also says that Kobernus, at R. 434, testified that "Hundreds were sold", referring to the Potter box. At R. 433, Kobernus said she did not know how many were sold, but only that she "demonstrated the use of several hundred". This is indeed a weak showing in view of the potential market.

The fact is, as appellant admits, that the Potter Company ended up in "financial disaster" (Aplt's Br. 65).

Appellant seeks to excuse this commercial failure by referring to Quinn's testimony that the "market was not ready" because of the increased cost of a two compartment refrigerator (Aplt's Br., 29-30).

As we have heretofore demonstrated, prior to Potter there was no "problem". "Moist cold" refrigeration, a finned coil, a "nonfrosting" coil, a two compartment refrigerator and all of the other features were old. The reason the refrigerator manufacturers did not adopt the expensive two compartment box was the competition with the low-cost, old icebox (see Quinn, R. 675).

Appellant's showing here is excuse after excuse for Potter's admitted commercial failure and "financial disaster" (Br., 65).

The Potter patent likewise has made no impression on the industry. There is no showing here of recognition of the patent by the industry. There is no evidence of manufacture or licensing under the reissue patent. The history of both the Potter refrigerator and the Potter patent is commercial failure.

Even if there had been commercial success of the patent in suit it could not fill the void of lack of invention. (*Jungersen v. Ostby & Barton Co., et al*, 335 U.S. 560, 93 L. Ed. 235 (1949) ).

**V. THE TRIAL COURT'S ORDER FOR A NEW TRIAL IS NOT REVIEWABLE. THE DAMAGES AWARDED BY THE JURY HAD NO RATIONAL BASIS.**

The Trial Court entered its order for a new trial in the event its judgment for defendant should be reversed



(R. 71). The grounds for the new trial were: (1) the verdict is contrary to the clear weight of the evidence, and (2) the damages awarded plaintiff are excessive (R. 71). The order for a new trial is not reviewable except for abuse of discretion. *Montgomery Ward & Co. v. Duncan*, 311 U.S. 243, 254, 85 L. Ed. 147 (1940); *Cone v. West Va. Pulp & Paper Co.*, 330 U.S. 212, 91 L. Ed. 849 (1947); *Binder v. Commercial Travelers Mutual Acc. Ass'n*, 2 Cir., 165 F. 2d 896, 901 (1947). While under the law the order of the District Court is not reviewable, the District Court was clearly correct in ordering a new trial in the alternative in view of the following facts.

Appellant's evidence of damages consisted of an answer by appellant's expert to a hypothetical question (R. 837-42). Assuming the correctness of the facts stated in the question, appellant's expert stated that in his opinion 10% of the factory price would be a reasonable royalty (R. 842). However, the question postulated that the patent in suit is a pioneer patent, specifically the "first major improvement in refrigeration for many years," and "a brand new idea in refrigeration, not just a new model." (R. 838).

The patents to Anderson, Davenport, Larkin, the testimony of appellant's expert, and the file wrappers of Bronaugh & Potter (Def. Ex. 101, 102) show that this assumed fact is not true.

The question also assumed that "the conventional refrigerators which had been produced in the United States in and prior to 1931 dried out the natural moisture in the foods stored therein because of the frosting of the chilling element within the food chamber, and that said fact had existed from the beginning of electri-



cal refrigeration, during which time a substantial amount of household electric refrigerators were produced in the United States" (R. 839).

However, Bronaugh testified that he and Potter prior to their alleged invention were buying Larkin finned coils from a Georgia factory and installing them in commercial refrigerator compartments to prevent the drying out of foods (R. 165-6). These refrigerators and compartments were conventional.

Since the appellant's hypothetical question was contrary to the established facts, there was no evidence on which the jury could have based its award. The jury's selection of approximately 5% of the factory price was without rational basis. It was clearly no abuse of discretion for the Trial Court to order alternatively a new trial.

**VI. APPELLANT'S CLAIM FOR TREBLE DAMAGES AGAINST ADMIRAL IS UNFOUNDED. THE TRIAL COURT'S DENIAL OF THE CLAIM IS REVIEWABLE ONLY FOR ABUSE OF DISCRETION.**

Appellant contends (Br. 64-66) that the damages awarded by the jury against Admiral should be trebled by this Court because of the "reckless, knowing and deliberate defiance and appropriation of the invention of the patent in suit" (Br. 66).

It has been shown that there was no "invention," and that Admiral appropriated nothing from Potter.

Appellant's charge of "reckless, knowing and deliberate defiance" is likewise without factual support.

Appellant desperately tries to impose on Admiral what appellant calls the "sordid" story of Stewart-Warner (Br. 65). Admiral bought from Stewart-Warner

certain assets relating to its refrigerator business (Pl. Ex. 4CC7-8), and some employees of Stewart-Warner came to Admiral (R. 959-61). Admiral assumed no liabilities. Stewart-Warner is not on trial here. In its desperation, appellant goes so far as to cite this Court a record reference in the Stewart-Warner case in the Seventh Circuit (Br. 65). Suffice it to say that the Seventh Circuit did not find Stewart-Warner's story "sordid." On the contrary, that Court upheld Stewart-Warner's resistance to Potter's baseless claims (159 F. 2d 972).

After the purchase from Stewart-Warner, Admiral redesigned the two-temperature refrigerator. Morton, chief engineer of Admiral, testified (R. 966):

"Admiral gave me no specific instructions at that time except they wanted to continue the two-temperature, and the problems that arose from Stewart-Warner system at that time were inability to service as an hermetic system and the period that Admiral was to provide that type of service system, which led us into a completely different path."

Admiral adopted the two circuit system here accused (R. 969), which, as has been shown, is not an appropriation of Potter.

The patent in suit was considered by Admiral, and the conclusion reached that it was not infringed (R. 978-9).

Mr. Siragusa, President of Admiral, testified that it was the policy of Admiral, if it felt it was violating a patent, to take a license or redesign its structure (R. 1029).

There was clearly no basis for treble damages here, and the Trial Court's denial of appellant's claim was correct.

In any event, under the Statute (35 U.S.C. 284), the matter is *discretionary* with the Trial Court. There is no showing here of an *abuse of discretion* (*Enterprise Mfg. Co. v. Shakespeare Co.*, 6 Cir., 141 F. 2d 916, 920-1 (1944) ).

# VII. APPELLANT'S CLAIM FOR COSTS AND ATTORNEYS' FEES BECAUSE OF APPELLEES' ALLEGED "DELAY" AND "BAD FAITH" IS UNFOUNDED.

The lengths to which appellant goes in charging appellees with "bad faith" and "delay" is illustrated by the following from appellant's brief, p. 68:

"They (appellees) also filed the ill-founded, unduly complicated motions for summary judgment which the trial Judge took from June 8, 1951, to March 21, 1953, to decide, almost 2/5th of the life of the reissue patent. This delay has resulted in substantial loss to the plaintiff."

The motion was not found to have been filed for delay or in bad faith by the Trial Court, which *upheld* the motion (Record on prior appeal in this case, No. 13811, p. 52), nor by this Court, which reversed (217 F. 2d 39), nor by the Supreme Court, which denied certiorari, 348 U.S. 952.

Appellant also charges appellees with bad faith because they "filed two vexatious and dilatory suits for declaratory judgment against plaintiff in the Southern District of New York" (Br. 67-8). The record in these New York cases is not a part of the record before this Court. Such an excursion outside the record exhibits only desperation.

The remaining contentions of appellant likewise fail to show "bad faith" or delay. Appellees have defended this case in good faith and with diligence.

The Trial Court did not abuse its discretion in ordering each party to bear its own costs.

## CONCLUSION

The Bronaugh & Potter patent is invalid because:

1. Each of the Anderson and Davenport (1,726,344) patents teaches the employment of the same elements as claimed by Bronaugh & Potter in the same organization (a household refrigerator) to produce the same results (a freezing compartment and a moist cold compartment in one box).

2. The Larkin patent teaches the use of a fin coil in a refrigerating compartment to produce a moist cold atmosphere and prevent dehydration of foods stored therein. This same Larkin fin coil was admittedly used by Bronaugh & Potter to produce a moist cold condition in a compartment of their patented refrigerator. Appellant's expert unequivocally stated at the trial that the difference between Bronaugh & Potter and Anderson was in Bronaugh & Potter's placing fins on the bare coils or pipes in the cooling compartment shown by Anderson.

3. Even if patents such as Anderson and Davenport had not shown the organization of elements as claimed by Bronaugh & Potter, the patent would be invalid as claiming an aggregation of old elements which, when brought together, perform no differently from the way they did before and produce no new or surprising result. Admittedly, freezing compartments, moist cold compartments, expansion valves, thermostats, etc., all existed before

Bronaugh & Potter. Their assemblage of these old parts produced exactly what could be expected—a unitary refrigerator having a freezing compartment and a moist cold compartment whose temperatures were controlled to the desired degrees by adjustments of the old adjustable parts.

4. If, as appellant's expert, Mr. Parker, maintained, the use of a finned coil was the invention made by Bronaugh & Potter there is no compliance with 35 U.S.C. 112 since admittedly such a fin coil is not described in the specification of Bronaugh & Potter.

5. The Bronaugh & Potter patent fails to meet the standards of invention of the U. S. Supreme Court and this Court. The patent is for an assembly of old elements as taught by Anderson and Davenport. Even the alleged difference between the Bronaugh & Potter patent and the prior art patents amounts at most to the adjustment of an adjustable valve (expansion valve) to produce less frosting in the cooling coil.

6. There was sale of the patented refrigerators more than two years prior to the assertion in the Patent Office of claimed subject matter and the patent is invalid for late claiming.

The claims of the Bronaugh & Potter patent are not infringed because:

1. The accused refrigerators are of the cold wall type (Davenport 1,726,344) which, according to appellant's witnesses, is different in structure, function and result from the finned coil type which the



Bronaugh & Potter refrigerator is supposed to be.

2. The claims of the patent call for a single liquefying unit and single refrigerant, and the accused refrigerators have two distinct, separate liquefying units containing two refrigerants.

3. There is no identity of structure, function and result between the accused and patented refrigerators.

4. If Bronaugh & Potter made any advance at all, it is a very slight one and the claims should be given no liberal construction such as would include the accused refrigerators which do not have fin coils that are the Bronaugh & Potter advance according to appellant's expert.

The reasons for holding the Bronaugh & Potter patent invalid and not infringed are based exclusively on the uncontradicted testimony of appellant's witnesses and the documentary evidence. As the Trial Judge held, this testimony and evidence unquestionably establishes invalidity and noninfringement of the patent.

The history of the Bronaugh & Potter patent spells out a story of commercial failure. This failure was due to the inherent worthlessness of the patent since the promoters, salesmen and advocates of the patent were obviously very competent men in their fields to be able to do what they did with this patent. Likewise, appellant's brief is an artfully contrived effort to give the impression that Bronaugh & Potter made some patent-worthy contribution to the sum of human knowledge. This is accomplished by disregarding the testimony of appellant's own witnesses and the plain teachings of the



prior art, and relying entirely on invective, bold unsupported statements, and sales talk.

In a desperate attempt to salvage something from the shambles of its ill-begotten patent and ill-founded claims, appellant asks this Court for not only re-instatement of the jury verdict, but treble damages plus costs and attorneys' fees. Such demands are undoubtedly based on the strategy that by asking for everything three times over, appellant hopes to end up with something. There is no more substance in these outrageous demands of appellant than there is in its patent.

There was no abuse of discretion by the Trial Judge in denying appellant's unfounded claims and in ordering a new trial in the alternative should his judgment of invalidity and noninfringement be set aside. Appellant's attack on the Trial Court is wholly unwarranted.

The Judgment of the Trial Court should be affirmed.

Respectfully submitted,

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is hereby accepted in..... Oregon, this

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Attorney... for.....